



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: David Barrington Everett et al.

Application No.: 09/932,013

Filed: August 17, 2001

**Title: SECURE MULTIPLE APPLICATION  
CARD SYSTEM AND PROCESS**

Group Art Unit: 2137

Examiner: Mathew Smithers

Attorney Docket No.: 40000059-0150

Confirmation No.: 4815

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, and is further being communicated to the USPTO by facsimile (without the enclosures) to (571)273-8300, ATTN: Office of Petitions on July 18, 2007

Edward J. Radio, Reg No. 26,793

Name of Person Mailing Correspondence

**Mail Stop PETITIONS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: 571-273-8300

**AMENDED PETITION UNDER 37 C.F.R. §1.55(c) AND PETITION UNDER 37 C.F.R.  
§1.78(a)(3)**

Sir:

On March 2, 2007, Applicants mailed and faxed to the United States Patent and Trademark Office (USPTO) a Renewed Petition under 37 C.F.R. §1.55(c) for acceptance of an unintentionally delayed claim of priority (the “Renewed Petition”), responsive to the Decision on Petition under 37 C.F.R. §1.55 mailed by the USPTO on January 30, 2007. In light of the USPTO’s Decision on Petitions under 37 C.F.R. §§1.55 and 1.78 mailed June 29, 2007 (the “June 29 Decision”), and a telephone conference between Applicants’ attorneys (Edward Radio and Michael Day) and Legal Examiner Lin held July 12, 2007, the present Amended Petition under 37 C.F.R. §1.55(c) and Petition Under 37 C.F.R. §1.78(a)(3) are submitted herewith. The following are submitted:

**Amended Petition under 37 C.F.R. §1.55(c)** begins on page 3 of this paper.

**Petition under 37 C.F.R. §1.78(a)(3)** begins on page 4 of this paper.

**Remarks** begin on page 5 of this paper.

**Enclosures (via USPS only):**

- (1) Cover page of Pub. No. US 2001/0056536A1 (27 Dec. 01)
- (2) USPTO “Bib Data Sheet” for the instant application

- (3) Printout of Parent Continuity Data from Public PAIR
- (4) Cover page of U.S. patent 6,317,832 B1 (the Parent), issued 13 Nov. 01, with Certificates of Correction
- (5) 66 FR 67087
- (6) MPEP 8th Edition, First Revision, February 2003, pp. 200-67 through 200-70
- (7) MPEP, 8th Edition, August 2001, pp. 200-66 through 200-69
- (8) Official Gazette Notice published 18 March 2003:  
<http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>
- (9) <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>

## **AMENDED PETITION UNDER 37 C.F.R. §1.55(c)**

Pursuant to 35 U.S.C. §119(a) and 35 U.S.C. §120, the instant application is entitled to the benefit of the filing date of the following prior application: Great Britain patent application No. 9703591.9 filed on February 21, 1997 and entitled “Multiple Application Computer System.” Applicants unintentionally failed to expressly claim this priority in the instant application as filed, and unintentionally failed to present this claim during the time period provided by 37 C.F.R. §1.55(a).

### **APPLICANTS HEREBY PETITION FOR ACCEPTANCE OF THE UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

**(1) CLAIM:** This application is a continuation of and claims priority to United States patent application no. 09/076,551, filed on May 12, 1998, entitled “Secure Multiple Application Card System and Process,” now U.S. patent 6,317,832, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled “Design for a Multi Application Smart Card” and United States provisional patent application 60/046,543 filed on May 15, 1997, entitled “Virtual Machine for a Multi Application Smart Card”; United States patent application no. 09/076,551 is a continuation of and claims priority to United States patent application 09/023,057 filed on February 12, 1998, entitled “Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability,” now U.S. patent 6,575,372, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled “Design for a Multi Application Smart Card” and Great Britain patent application 9703591.9 filed on February 21, 1997, entitled “Multiple Application Computer System.

**(2) PETITION FEE:** The surcharge of one thousand three hundred seventy dollars (\$1,370.00) set forth in 37 C.F.R. §1.17(t) for a large entity was included with the original Petition to Accept Unintentionally Delayed Claim of Priority, mailed November 20, 2006.

**(3) STATEMENT:** The entire delay between the date the claim was due under 37 C.F.R. §1.55(a)(1) and the date the claim was filed was unintentional.

## **PETITION UNDER 37 C.F.R. §1.78(a)(3)**

Pursuant to 35 U.S.C. §120, the instant application is entitled to the benefit of the filing date of the following prior application: United States patent application 09/023,057 filed on February 12, 1998, entitled “Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability,” now U.S. patent 6,575,372 (the “Grandparent”). Applicants expressly claimed priority to said Grandparent in the first sentence following the title of the instant application as originally filed, as required by 37 C.F.R. §1.78 (a)(2)(iii), and accurately identified the instant application as “a continuation of” the intermediate prior application 09/076,551 (the “Parent”), but did not expressly state in the instant application that the Parent is “a continuation of” the Grandparent.

### **APPLICANTS HEREBY PETITION FOR ACCEPTANCE OF THE UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

**(1) CLAIM:** This application is a continuation of and claims priority to United States patent application no. 09/076,551, filed on May 12, 1998, entitled “Secure Multiple Application Card System and Process,” now U.S. patent 6,317,832, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled “Design for a Multi Application Smart Card” and United States provisional patent application 60/046,543 filed on May 15, 1997, entitled “Virtual Machine for a Multi Application Smart Card”; United States patent application no. 09/076,551 is a continuation of and claims priority to United States patent application 09/023,057 filed on February 12, 1998, entitled “Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability,” now U.S. patent 6,575,372, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled “Design for a Multi Application Smart Card” and Great Britain patent application 9703591.9 filed on February 21, 1997, entitled “Multiple Application Computer System.

**(2) PETITION FEE:** The surcharge of one thousand three hundred seventy dollars (\$1,370.00) set forth in 37 C.F.R. §1.17(t) for a large entity was included with the original Petition to Accept Unintentionally Delayed Claim of Priority, filed November 20, 2006.

**(3) STATEMENT:** The entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2) and the date the claim was filed was unintentional.

## REMARKS

Favorable consideration of this Amended Petition under 37 C.F.R. §1.55(c) and Petition under 37 C.F.R. §1.78(a)(3) (the “Instant Petitions”) is hereby respectfully requested.

In the June 29 Decision, the USPTO dismissed the Renewed Petition under 37 C.F.R. §1.55(c) filed on March 2, 2007, concluding that (1) “the instant application does not contain a proper benefit claim under 35 U.S.C. 120 and 37 C.F.R. 1.78(a)(2) to U.S. application number 09/023,057” (the Grandparent), and (2) the Renewed Petition, when treated as a petition under 37 C.F.R. §1.78 to accept an unintentionally delayed claim under 35 U.S.C. §120 to U.S. application 09/023,057 (the Grandparent), was defective.

Reconsideration of the June 29 Decision, and acceptance of the priority claims to the Grandparent and to Great Britain application 9703591.9 are appropriate, for at least the following reasons: (1) the instant application, as amended for publication, included a proper priority benefit claim under 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2) to the Grandparent; (2) the June 29 Decision improperly retroactively applied MPEP provisions published after the instant application was filed; and (3) the June 29 Decision is contrary to the USPTO practice announced December 28, 2001 at 66 FR 67087, 67091 (Enclosure 5). The foregoing three reasons are each elaborated below under the corresponding numbered paragraphs.

1. Any failure of the Applicants to comply with 37 C.F.R. §1.78(a)(2) in the application-as-filed was cured by publication of the application on December 27, 2001 (the “Amended Application”). As amended for publication by the USPTO, the priority claim in the Amended Application, item (63) on the cover sheet of Pub. No. US 2001/0056536 (enclosure 1), states “Continuation of application No. 09/076,551, filed on May 12, 1998, now Pat. No. 6,317,832, which is a non-provisional of provisional application No. 60/046,514, filed on May 15, 1997 and which is a non-provisional of provisional application No. 60/046,543, filed on May 15, 1997 and which is a continuation of application No. 09/023,057, filed on Feb. 12, 1998.” This priority claim expressly states that the Parent is “a continuation of” the Grandparent. As provided by 37 C.F.R. §1.78 (a)(2)(iii), “the specification must contain or be amended to contain such

reference in the first sentence(s) following the title.” [emphasis added]. Similar language is provided in 37 C.F.R. §1.78 (a)(2)(i). Nothing in 37 C.F.R. §1.78(a)(2)(i) or (iii) requires that the specification be amended by Applicants. Here, the application-as-filed was amended by the USPTO, as permitted by 37 C.F.R. §1.78 (a)(2)(i) and (iii), and the published amended application satisfies the requirements of 37 C.F.R. §1.78(a)(2)(i) and (iii).

2. The June 29 Decision is improperly grounded on language from an August 2006 version of MPEP 201.11(III)(A) that post-dates the filing of the instant application. The MPEP language cited by the USPTO (“if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications”) was first introduced to the MPEP in February 2003, eighteen months after the instant application was filed, and identifies new requirements not stated in the MPEP version(s) extant as of the 2001 filing date. [compare pages 200-67 through 200-70 of Feb 2003 MPEP (Enclosure 6) with pages 200-66 through 200-69 of Aug. 2001 MPEP (Enclosure 7)]. The background and rationale for this change, implemented by the USPTO in February 2003, may be found in the Official Gazette Notice published 18 March 2003 [Enclosure 8, <http://www.uspto.gov/web/offices/com/og/2003/week11/patbene.htm>]

Nothing in the MPEP or the related Official Gazette Notice suggests that this policy change was intended to be applied retroactively. Doing so in the case of the instant application is both unfair and unnecessary, since, as stated above, the instant application was amended within five months of its filing date by the USPTO to expressly state that the Parent is “a continuation of” the Grandparent.

As of the filing date of the instant application, both the MPEP and 37 C.F.R. §1.78 required identifying only the “relationship” of the applications in the priority chain, without defining “relationship.” The word “relationship” could be construed to mean “A claims priority upon B” as easily as “A is a continuation of B”. It is evident from Enclosure 8 that many applicants and practitioners so construed “relationship” [see section entitled “Statement of the Problem]. Remarkably, although the MPEP revision of February 2003 clarifies the USPTO’s definition of “relationship”, 37 C.F.R. §1.78 to this

very day still fails to incorporate such definition, notwithstanding that 37 C.F.R. §1.78 has been amended six times since the instant application was filed.

3. Although the first sentence of the instant application's specification-as-filed did not expressly state that the Parent is "a continuation of" the Grandparent, the fact of the continuation relationship between Parent and Grandparent has been amply recognized by the USPTO and identified to the public since at least November 13, 2001, by way of at least the following:

(1) the application as published on December 27, 2001 (cover, item (63))

(Enclosure 1)

(2) the USPTO's Bibliographic Data Sheet (Enclosure 2)

(3) Public PAIR's continuity database (Enclosure 3)

(4) The face of the issued Parent, U.S. patent no. 6,317,832 (issued November 13, 2001) (Enclosure 4)

Given that the above-listed publicly available references expressly stated that the Parent is "a continuation of" the Grandparent, Applicants had no reason to believe that the priority benefit claim to the Grandparent application under 35 U.S.C. §120 required any correction, particularly in light of the following announced Office practice:

"The Office has adopted the following practice: if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. 66 FR 67087, 67091 [Enclosure 5 (emphasis added)].

Applicants have been unable to locate a copy of the instant application's filing receipt, which should have been mailed to the Manhattan, New York, NY, mailing address of Applicants' former attorney of record. During a telephone conference

conducted on July 16, 2007 between Michael Day of Sonnenschein Nath & Rosenthal LLP, and Valarie Kinard, a supervisor in the Office of Initial Patent Examination at the USPTO, Ms. Kinard indicated that, according to the USPTO's records, the filing receipt was mailed on September 14, 2001. Ms. Kinard further indicated that the USPTO itself did not retain either a physical copy or a scanned image of the originally mailed filing receipt. Applicants surmise that the 2001 filing receipt was lost as a result of the postal service interruptions associated with the tragic events of September 11, 2001 (see, e.g., <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>, Enclosure 9).

The four above-listed references published by the USPTO at about the same time as the originally-mailed filing receipt provide uncontroverted evidence that this originally-mailed filing receipt included the same domestic priority data as those four references, thereby satisfying the requirements of the above-cited USPTO practice, as memorialized in the Federal Register.

Thus, in accordance with the announced USPTO practice, Applicants' correction of the specification to conform with the filing receipt may be accomplished informally, without the need for a petition for a delayed priority claim.

### Conclusion

Whether or not an amendment can be entered into the application at this time under 37 C.F.R. §1.312, Applicants earnestly request that the June 29 Decision be reconsidered and the Instant Petitions be granted. Thereby, Applicants will be afforded a clear statement from the USPTO that Applicants have secured the priority claims to which they are entitled. Applicants will then determine with the responsible USPTO Examiner how to best implement the new decision in the instant application. Therefore, Applicants respectfully request the USPTO to (1) suspend issuance of the instant application until the USPTO disposes of the Instant Petitions; (2) grant the Instant Petitions; and, (3) return the instant application for further prosecution in accordance with the granted Instant Petitions.

If there are any additional fees due in connection with this communication,  
please charge Deposit Account No. 19-3140. This sheet is being submitted in duplicate.

Respectfully submitted,

*Edward J. Radlo*  
Edward J. Radlo  
Attorney of Record  
Reg. No. 26,793  
July 18, 2007

SONNENSCHEIN NATH & ROSENTHAL LLP  
P. O. Box 061080  
Wacker Drive Station, Sears Tower  
Chicago, Illinois 60606-1080  
(415) 882-2402

**Enclosures (via USPS only):**

- (1) Cover page of Pub. No. US 2001/0056536A1 (27 Dec. 01)
- (2) USPTO "Bib Data Sheet" for the instant application
- (3) Printout of Parent Continuity Data from Public PAIR
- (4) Cover page of U.S. patent 6,317,832 B1 (the Parent), issued 13 Nov. 01, with Certificates of Correction
- (5) 66 FR 67087
- (6) MPEP 8th Edition, First Revision, February 2003, pp. 200-67 through 200-70
- (7) MPEP, 8th Edition, August 2001, pp. 200-66 through 200-69
- (8) Official Gazette Notice published 18 March 2003:  
<http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>
- (9) <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>

cc: B. McKeon (w/ encl.)  
IP/T docket CH (w/o encl.)

# Sonnenschein

SONNENSCHEIN NATH & ROSENTHAL LLP

## Facsimile Transmittal Sheet



DATE • July 18, 2007

525 Market Street  
26th Floor  
San Francisco, CA 94105-2708  
415.882.5000  
415.882.0300 fax  
[www.sonnenschein.com](http://www.sonnenschein.com)

### PLEASE DELIVER THE FOLLOWING PAGES TO:

NAME • MAIL STOP PETITIONS

FIRM • USPTO

PHONE •

FAX • (571) 273-8300

CLIENT / 40000059-0150

MATTER •

FROM • Michael L. Day

TOTAL NUMBER OF PAGES TRANSMITTED, INCLUDING THIS SHEET: 10

### MESSAGE •

AMENDED PETITION UNDER 37 CFR §1.55(c) follows for Application No. 09/932,013, Filed August 17, 2001

27261988IV-1

Please Note: Pages 1-10  
were prev. faxed to  
the USPTO on  
July 18, 2008

Original will NOT be mailed

CONFIDENTIALITY NOTE

This Mailing includes additional  
Enclosures.

The documents accompanying this facsimile transmission and the Facsimile Transmission Sheet contain information from the law firm of Sonnenschein Nath & Rosenthal LLP which is confidential or privileged. The information is intended to be for the use of the individual or entity named on this transmission sheet. If you are not the intended recipient, be aware that any disclosure, copying, distribution or use of the contents of this facsimiled information is prohibited. If you have received this facsimile in error, please notify us by telephone immediately so that we can arrange for the retrieval of the original documents at no cost to you.

IF YOU DO NOT RECEIVE ALL OF THE PAGES ABOVE, PLEASE CALL 415.882.5000 AS SOON AS POSSIBLE.

SN&R FACSIMILE DEPARTMENT USE ONLY:

TRANSMISSION COMPLETED AT:

DOCUMENT TRANSMITTED BY:

Brussels

Chicago

Kansas City

Los Angeles

New York

Phoenix

St. Louis

San Francisco

Short Hills, N.J.

Washington, D.C.

West Palm Beach



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: David Barrington Everett et al.

Application No.: 09/932,013

Filed: August 17, 2001

**Title: SECURE MULTIPLE APPLICATION  
CARD SYSTEM AND PROCESS**

Group Art Unit: 2137

Examiner: Mathew Smithers

Attorney Docket No.: 40000059-0150

Confirmation No.: 4815

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, and is further being communicated to the USPTO by facsimile (without the enclosures) to (571)273-8300, ATTN: Office of Petitions on July 18, 2007

Date of Deposit

Edward J. Radlo, Reg No. 26,793  
Name of Person Mailing Correspondence

**Mail Stop PETITIONS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: 571-273-8300

**AMENDED PETITION UNDER 37 C.F.R. §1.55(c) AND PETITION UNDER 37 C.F.R.  
§1.78(a)(3)**

Sir:

On March 2, 2007, Applicants mailed and faxed to the United States Patent and Trademark Office (USPTO) a Renewed Petition under 37 C.F.R. §1.55(c) for acceptance of an unintentionally delayed claim of priority (the “Renewed Petition”), responsive to the Decision on Petition under 37 C.F.R. §1.55 mailed by the USPTO on January 30, 2007. In light of the USPTO’s Decision on Petitions under 37 C.F.R. §§1.55 and 1.78 mailed June 29, 2007 (the “June 29 Decision”), and a telephone conference between Applicants’ attorneys (Edward Radlo and Michael Day) and Legal Examiner Lin held July 12, 2007, the present Amended Petition under 37 C.F.R. §1.55(c) and Petition Under 37 C.F.R. §1.78(a)(3) are submitted herewith. The following are submitted:

**Amended Petition under 37 C.F.R. §1.55(c)** begins on page 3 of this paper.

**Petition under 37 C.F.R. §1.78(a)(3)** begins on page 4 of this paper.

**Remarks** begin on page 5 of this paper.

**Enclosures (via USPS only):**

- (1) Cover page of Pub. No. US 2001/0056536A1 (27 Dec. 01)
- (2) USPTO “Bib Data Sheet” for the instant application

- (3) Printout of Parent Continuity Data from Public PAIR
- (4) Cover page of U.S. patent 6,317,832 B1 (the Parent), issued 13 Nov. 01, with Certificates of Correction
- (5) 66 FR 67087
- (6) MPEP 8th Edition, First Revision, February 2003, pp. 200-67 through 200-70
- (7) MPEP, 8th Edition, August 2001, pp. 200-66 through 200-69
- (8) Official Gazette Notice published 18 March 2003:  
<http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>
- (9) <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>

## **AMENDED PETITION UNDER 37 C.F.R. §1.55(c)**

Pursuant to 35 U.S.C. §119(a) and 35 U.S.C. §120, the instant application is entitled to the benefit of the filing date of the following prior application: Great Britain patent application No. 9703591.9 filed on February 21, 1997 and entitled "Multiple Application Computer System." Applicants unintentionally failed to expressly claim this priority in the instant application as filed, and unintentionally failed to present this claim during the time period provided by 37 C.F.R. §1.55(a).

### **APPLICANTS HEREBY PETITION FOR ACCEPTANCE OF THE UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

**(1) CLAIM:** This application is a continuation of and claims priority to United States patent application no. 09/076,551, filed on May 12, 1998, entitled "Secure Multiple Application Card System and Process," now U.S. patent 6,317,832, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled "Design for a Multi Application Smart Card" and United States provisional patent application 60/046,543 filed on May 15, 1997, entitled "Virtual Machine for a Multi Application Smart Card"; United States patent application no. 09/076,551 is a continuation of and claims priority to United States patent application 09/023,057 filed on February 12, 1998, entitled "Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability," now U.S. patent 6,575,372, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled "Design for a Multi Application Smart Card" and Great Britain patent application 9703591.9 filed on February 21, 1997, entitled "Multiple Application Computer System.

**(2) PETITION FEE:** The surcharge of one thousand three hundred seventy dollars (\$1,370.00) set forth in 37 C.F.R. §1.17(t) for a large entity was included with the original Petition to Accept Unintentionally Delayed Claim of Priority, mailed November 20, 2006.

**(3) STATEMENT:** The entire delay between the date the claim was due under 37 C.F.R. §1.55(a)(1) and the date the claim was filed was unintentional.

## **PETITION UNDER 37 C.F.R. §1.78(a)(3)**

Pursuant to 35 U.S.C. §120, the instant application is entitled to the benefit of the filing date of the following prior application: United States patent application 09/023,057 filed on February 12, 1998, entitled “Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability,” now U.S. patent 6,575,372 (the “Grandparent”). Applicants expressly claimed priority to said Grandparent in the first sentence following the title of the instant application as originally filed, as required by 37 C.F.R. §1.78 (a)(2)(iii), and accurately identified the instant application as “a continuation of” the intermediate prior application 09/076,551 (the “Parent”), but did not expressly state in the instant application that the Parent is “a continuation of” the Grandparent.

### **APPLICANTS HEREBY PETITION FOR ACCEPTANCE OF THE UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY**

**(1) CLAIM:** This application is a continuation of and claims priority to United States patent application no. 09/076,551, filed on May 12, 1998, entitled “Secure Multiple Application Card System and Process,” now U.S. patent 6,317,832, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled “Design for a Multi Application Smart Card” and United States provisional patent application 60/046,543 filed on May 15, 1997, entitled “Virtual Machine for a Multi Application Smart Card”; United States patent application no. 09/076,551 is a continuation of and claims priority to United States patent application 09/023,057 filed on February 12, 1998, entitled “Secure Multi-Application IC Card System Having Selective Loading and Deleting Capability,” now U.S. patent 6,575,372, which claims the priority benefit of United States provisional patent application 60/046,514 filed on May 15, 1997, entitled “Design for a Multi Application Smart Card” and Great Britain patent application 9703591.9 filed on February 21, 1997, entitled “Multiple Application Computer System.

**(2) PETITION FEE:** The surcharge of one thousand three hundred seventy dollars (\$1,370.00) set forth in 37 C.F.R. §1.17(t) for a large entity was included with the original Petition to Accept Unintentionally Delayed Claim of Priority, filed November 20, 2006.

**(3) STATEMENT:** The entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2) and the date the claim was filed was unintentional.

## REMARKS

Favorable consideration of this Amended Petition under 37 C.F.R. §1.55(c) and Petition under 37 C.F.R. §1.78(a)(3) (the "Instant Petitions") is hereby respectfully requested.

In the June 29 Decision, the USPTO dismissed the Renewed Petition under 37 C.F.R. §1.55(c) filed on March 2, 2007, concluding that (1) "the instant application does not contain a proper benefit claim under 35 U.S.C. 120 and 37 C.F.R. 1.78(a)(2) to U.S. application number 09/023,057" (the Grandparent), and (2) the Renewed Petition, when treated as a petition under 37 C.F.R. §1.78 to accept an unintentionally delayed claim under 35 U.S.C. §120 to U.S. application 09/023,057 (the Grandparent), was defective.

Reconsideration of the June 29 Decision, and acceptance of the priority claims to the Grandparent and to Great Britain application 9703591.9 are appropriate, for at least the following reasons: (1) the instant application, as amended for publication, included a proper priority benefit claim under 35 U.S.C. §120 and 37 C.F.R. §1.78(a)(2) to the Grandparent; (2) the June 29 Decision improperly retroactively applied MPEP provisions published after the instant application was filed; and (3) the June 29 Decision is contrary to the USPTO practice announced December 28, 2001 at 66 FR 67087, 67091 (Enclosure 5). The foregoing three reasons are each elaborated below under the corresponding numbered paragraphs.

1. Any failure of the Applicants to comply with 37 C.F.R. §1.78(a)(2) in the application-as-filed was cured by publication of the application on December 27, 2001 (the "Amended Application"). As amended for publication by the USPTO, the priority claim in the Amended Application, item (63) on the cover sheet of Pub. No. US 2001/0056536 (enclosure 1), states "Continuation of application No. 09/076,551, filed on May 12, 1998, now Pat. No. 6,317,832, which is a non-provisional of provisional application No. 60/046,514, filed on May 15, 1997 and which is a non-provisional of provisional application No. 60/046,543, filed on May 15, 1997 and which is a continuation of application No. 09/023,057, filed on Feb. 12, 1998." This priority claim expressly states that the Parent is "a continuation of" the Grandparent. As provided by 37 C.F.R. §1.78 (a)(2)(iii), "the specification must contain or be amended to contain such

reference in the first sentence(s) following the title.” [emphasis added]. Similar language is provided in 37 C.F.R. §1.78 (a)(2)(i). Nothing in 37 C.F.R. §1.78(a)(2)(i) or (iii) requires that the specification be amended by Applicants. Here, the application-as-filed was amended by the USPTO, as permitted by 37 C.F.R. §1.78 (a)(2)(i) and (iii), and the published amended application satisfies the requirements of 37 C.F.R. §1.78(a)(2)(i) and (iii).

2. The June 29 Decision is improperly grounded on language from an August 2006 version of MPEP 201.11(III)(A) that post-dates the filing of the instant application. The MPEP language cited by the USPTO (“if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications”) was first introduced to the MPEP in February 2003, eighteen months after the instant application was filed, and identifies new requirements not stated in the MPEP version(s) extant as of the 2001 filing date. [compare pages 200-67 through 200-70 of Feb 2003 MPEP (Enclosure 6) with pages 200-66 through 200-69 of Aug. 2001 MPEP (Enclosure 7)]. The background and rationale for this change, implemented by the USPTO in February 2003, may be found in the Official Gazette Notice published 18 March 2003 [Enclosure 8, <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>]

Nothing in the MPEP or the related Official Gazette Notice suggests that this policy change was intended to be applied retroactively. Doing so in the case of the instant application is both unfair and unnecessary, since, as stated above, the instant application was amended within five months of its filing date by the USPTO to expressly state that the Parent is “a continuation of” the Grandparent.

As of the filing date of the instant application, both the MPEP and 37 C.F.R. §1.78 required identifying only the “relationship” of the applications in the priority chain, without defining “relationship.” The word “relationship” could be construed to mean “A claims priority upon B” as easily as “A is a continuation of B”. It is evident from Enclosure 8 that many applicants and practitioners so construed “relationship” [see section entitled “Statement of the Problem]. Remarkably, although the MPEP revision of February 2003 clarifies the USPTO’s definition of “relationship”, 37 C.F.R. §1.78 to this

very day still fails to incorporate such definition, notwithstanding that 37 C.F.R. §1.78 has been amended six times since the instant application was filed.

3. Although the first sentence of the instant application's specification-as-filed did not expressly state that the Parent is "a continuation of" the Grandparent, the fact of the continuation relationship between Parent and Grandparent has been amply recognized by the USPTO and identified to the public since at least November 13, 2001, by way of at least the following:

- (1) the application as published on December 27, 2001 (cover, item (63))  
(Enclosure 1)
- (2) the USPTO's Bibliographic Data Sheet (Enclosure 2)
- (3) Public PAIR's continuity database (Enclosure 3)
- (4) The face of the issued Parent, U.S. patent no. 6,317,832 (issued November 13, 2001) (Enclosure 4)

Given that the above-listed publicly available references expressly stated that the Parent is "a continuation of" the Grandparent, Applicants had no reason to believe that the priority benefit claim to the Grandparent application under 35 U.S.C. §120 required any correction, particularly in light of the following announced Office practice:

"The Office has adopted the following practice: if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. 66 FR 67087, 67091 [Enclosure 5 (emphasis added)].

Applicants have been unable to locate a copy of the instant application's filing receipt, which should have been mailed to the Manhattan, New York, NY, mailing address of Applicants' former attorney of record. During a telephone conference

conducted on July 16, 2007 between Michael Day of Sonnenschein Nath & Rosenthal LLP, and Valarie Kinard, a supervisor in the Office of Initial Patent Examination at the USPTO, Ms. Kinard indicated that, according to the USPTO's records, the filing receipt was mailed on September 14, 2001. Ms. Kinard further indicated that the USPTO itself did not retain either a physical copy or a scanned image of the originally mailed filing receipt. Applicants surmise that the 2001 filing receipt was lost as a result of the postal service interruptions associated with the tragic events of September 11, 2001 (see, e.g., <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>, Enclosure 9).

The four above-listed references published by the USPTO at about the same time as the originally-mailed filing receipt provide uncontroverted evidence that this originally-mailed filing receipt included the same domestic priority data as those four references, thereby satisfying the requirements of the above-cited USPTO practice, as memorialized in the Federal Register.

Thus, in accordance with the announced USPTO practice, Applicants' correction of the specification to conform with the filing receipt may be accomplished informally, without the need for a petition for a delayed priority claim.

### Conclusion

Whether or not an amendment can be entered into the application at this time under 37 C.F.R. §1.312, Applicants earnestly request that the June 29 Decision be reconsidered and the Instant Petitions be granted. Thereby, Applicants will be afforded a clear statement from the USPTO that Applicants have secured the priority claims to which they are entitled. Applicants will then determine with the responsible USPTO Examiner how to best implement the new decision in the instant application. Therefore, Applicants respectfully request the USPTO to (1) suspend issuance of the instant application until the USPTO disposes of the Instant Petitions; (2) grant the Instant Petitions; and, (3) return the instant application for further prosecution in accordance with the granted Instant Petitions.

If there are any additional fees due in connection with this communication,  
please charge Deposit Account No. 19-3140. This sheet is being submitted in duplicate.

Respectfully submitted,

*Edward J. Radlo*  
Edward J. Radlo  
Attorney of Record  
Reg. No. 26,793  
*July 18, 2007*

SONNENSCHEIN NATH & ROSENTHAL LLP  
P. O. Box 061080  
Wacker Drive Station, Sears Tower  
Chicago, Illinois 60606-1080  
(415) 882-2402

**Enclosures (via USPS only):**

- (1) Cover page of Pub. No. US 2001/0056536A1 (27 Dec. 01)
- (2) USPTO "Bib Data Sheet" for the instant application
- (3) Printout of Parent Continuity Data from Public PAIR
- (4) Cover page of U.S. patent 6,317,832 B1 (the Parent), issued 13 Nov. 01, with Certificates of Correction
- (5) 66 FR 67087
- (6) MPEP 8th Edition, First Revision, February 2003, pp. 200-67 through 200-70
- (7) MPEP, 8th Edition, August 2001, pp. 200-66 through 200-69
- (8) Official Gazette Notice published 18 March 2003:  
<http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>
- (9) <http://www.uspto.gov/emergencyalerts/uspsnotice01.htm>

cc: B. McKeon (w/ encl.)  
IP/T docket CH (w/o encl.)



US 20010056536A1

(19) United States

(12) Patent Application Publication

Everett et al.

(10) Pub. No.: US 2001/0056536 A1

(43) Pub. Date: Dec. 27, 2001

(54) SECURE MULTIPLE APPLICATION CARD  
SYSTEM AND PROCESS

(76) Inventors: David Barrington Everett, East Sussex (GB); Stuart James Miller, Berks (GB); Anthony David Peacham, Kent (GB); Ian Stephen Simmons, Cambs (GB); Timothy Philip Richards, Herts (GB); John Charles Viner, Windlesham (GB)

Correspondence Address:

BAKER & BOTT  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

(21) Appl. No.: 09/932,013

(22) Filed: Aug. 17, 2001

Related U.S. Application Data

(63) Continuation of application No. 09/076,551, filed on May 12, 1998, now Pat. No. 6,317,832, which is a

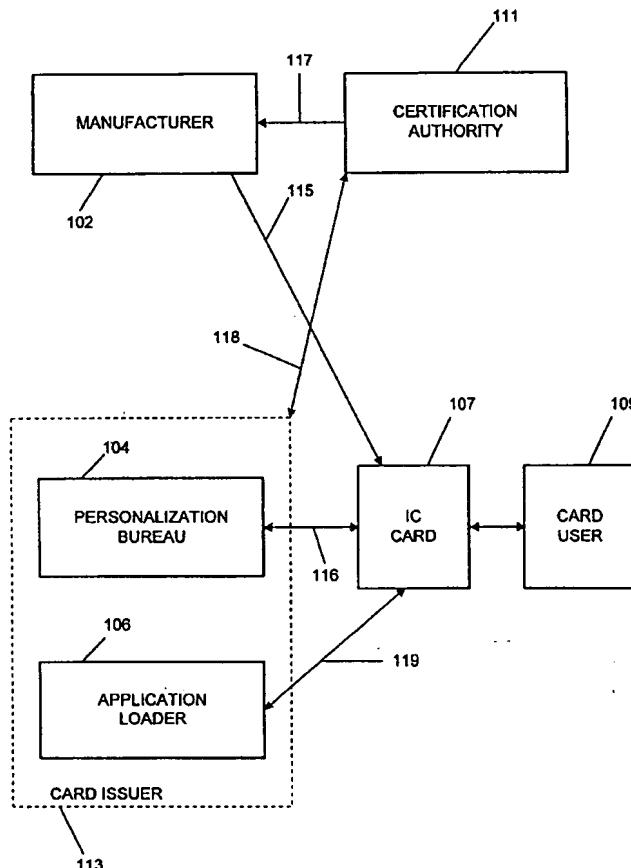
non-provisional of provisional application No. 60/046,514, filed on May 15, 1997 and which is a non-provisional of provisional application No. 60/046,543, filed on May 15, 1997 and which is a continuation of application No. 09/023,057, filed on Feb. 12, 1998.

Publication Classification

(51) Int. Cl. 7 ..... H04L 9/00  
(52) U.S. Cl. ..... 713/172

(57) ABSTRACT

A secure multiple application card system and process is provided having secure loading and deleting capability by use of a Certification Authority and Personalization Bureau. The certification authority maintains the security of the system by requiring IC cards to be injected with its public key and a card identifier for uniquely identifying each card, by providing a personalization data block for each card, and by signing with its private key all applications to be loaded or deleted from the IC card.



ENCLOSURE 1

09/932,013

AMENDED PETITION UNDER 37 CFR §1.55(c)



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov



Bib Data Sheet

CONFIRMATION NO. 4815

SERIAL NUMBER 09/932,013	FILING DATE 08/17/2001 RULE	CLASS 713	GROUP ART UNIT 2132	ATTORNEY DOCKET NO. A31510-072817- 0139
-----------------------------	-----------------------------------	--------------	------------------------	--

## APPLICANTS

David Barrington Everett, East Sussex, UNITED KINGDOM;  
Stuart James Miller, Berks, UNITED KINGDOM;  
Anthony David Peacham, Kent, UNITED KINGDOM;  
Ian Stephen Simmons, Cambs, UNITED KINGDOM;  
Timothy Philip Richards, Herts, UNITED KINGDOM;  
John Charles Viner, Windlesham, UNITED KINGDOM;

## \*\* CONTINUING DATA \*\*\*\*\*

THIS APPLICATION IS A CON OF 09/076,551 05/12/1998, now U.S. patent 6,317,832  
WHICH CLAIMS BENEFIT OF 60/046,514 05/15/1997  
AND CLAIMS BENEFIT OF 60/046,543 05/15/1997  
AND A CON OF 09/023,057 02/12/1998, now U.S. patent 6,575,372

## \*\* FOREIGN APPLICATIONS \*\*\*\*\*

## IF REQUIRED, FOREIGN FILING LICENSE GRANTED

\*\* 09/14/2001

Foreign Priority claimed	<input type="checkbox"/> yes <input type="checkbox"/> no	STATE OR COUNTRY UNITED KINGDOM	SHEETS DRAWING 11	TOTAL CLAIMS 4	INDEPENDENT CLAIMS 4
35 USC 119 (a-d) conditions met	<input type="checkbox"/> yes <input type="checkbox"/> no <input type="checkbox"/> Met after Allowance				
Verified and Acknowledged	Examiner's Signature Initials				

## ADDRESS

21003

## TITLE

Secure multiple application card system and process

FILING FEE RECEIVED 790	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<input type="checkbox"/> All Fees <input type="checkbox"/> 1.16 Fees ( Filing ) <input type="checkbox"/> 1.17 Fees ( Processing Ext. of time ) <input type="checkbox"/> 1.18 Fees ( Issue ) <input type="checkbox"/> Other _____ <input type="checkbox"/> Credit
----------------------------	---	---

ENCLOSURE 2

09/932,013

AMENDED PETITION UNDER 37 CFR §1.55(c)

09/076,551 SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS 07-18-  
2007::19:21:08

**Parent Continuity Data**

Description	Parent Number	Parent Filing or 371 (c) Date	Parent Status	Patent Number
This application is a Continuation of	09/023,057	02-12-1998	Patented	6,575,372
Claims Priority from Provisional Application	60/046,514	05-15-1997	Expired	-
Claims Priority from Provisional Application	60/046,543	05-15-1997	Expired	-

**Child Continuity Data**

09/932,013 filed on 08-17-2001 which is Pending claims the benefit of 09/076,551  
11/655,497 filed on 01-19-2007 which is Pending claims the benefit of 09/076,551  
11/707,824 filed on 02-16-2007 which is Pending claims the benefit of 09/076,551  
11/729,509 filed on 03-29-2007 which is Pending claims the benefit of 09/076,551  
11/821,052 filed on null which is Pending claims the benefit of 09/076,551

[Close Window](#)

ENCLOSURE 3

09/932,013  
AMENDED PETITION UNDER 37 CFR §1.55(c)



US006317832B1

(12) **United States Patent**  
Everett et al.

(10) **Patent No.:** US 6,317,832 B1  
(45) **Date of Patent:** Nov. 13, 2001

(54) **SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS**

(75) **Inventors:** David Barrington Everett, East Sussex; Stuart James Miller, Berks; Anthony David Peacham, Kent; Ian Stephen Simmons, Cambs; Timothy Philip Richards, Herts; John Charles Viner, Windlesham, all of (GB)

(73) **Assignee:** Mondex International Limited, London (GB)

(\*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) **Appl. No.:** 09/076,551

(22) **Filed:** May 12, 1998

**Related U.S. Application Data**

(63) Continuation of application No. 09/023,057, filed on Feb. 12, 1998.

(60) Provisional application No. 60/046,543, filed on May 15, 1997, and provisional application No. 60/046,514, filed on May 15, 1997.

(51) **Int. Cl.:** H04L 9/00

(52) **U.S. Cl.:** 713/172

(58) **Field of Search:** 713/156, 166, 713/172, 187

(56) **References Cited**

**U.S. PATENT DOCUMENTS**

4,882,474 11/1989 Anderl et al. .

4,901,276	2/1990	Iijima .
4,949,257	8/1990	Orbach .....
5,014,312	5/1991	Lisimaque et al. .
5,162,989	11/1992	Matsuda .....
5,293,577	3/1994	Hueske et al. .
5,378,884 *	1/1995	Lundstrom et al. .....
5,452,431	9/1995	Bournas .
5,581,708	12/1996	Iijima .
5,588,146	12/1996	Leroux .
5,682,027	10/1997	Bertina et al. .
5,796,831	8/1998	Paradinas et al. .
5,825,875	10/1998	Ugon .
5,841,870 *	11/1998	Fieres et al. .....
5,889,941 *	3/1999	Tushie et al. .....
6,005,942 *	12/1999	Chan et al. .....
6,038,551 *	3/2000	Barlow et al. .....

**FOREIGN PATENT DOCUMENTS**

0152024 8/1985 (EP).  
0157303 10/1985 (EP). .

(List continued on next page.)

**Primary Examiner**—Tod Swann

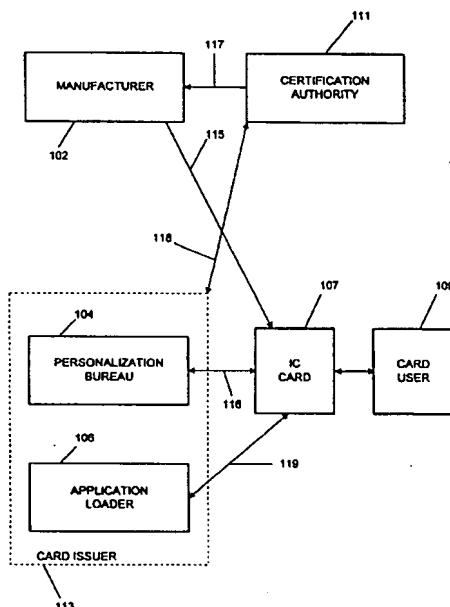
**Assistant Examiner**—Matthew Smithers

(74) **Attorney, Agent, or Firm:** Baker Botts L.L.P.

(57) **ABSTRACT**

A secure multiple application card system and process is provided having secure loading and deleting capability by use of a Certification Authority and Personalization Bureau. The certification authority maintains the security of the system by requiring IC cards to be injected with its public key and a card identifier for uniquely identifying each card, by providing a personalization data block for each card, and by signing with its private key all applications to be loaded or deleted from the IC card.

**10 Claims, 11 Drawing Sheets**



**ENCLOSURE 4**

**09/932,013**

AMENDED PETITION UNDER 37 CFR §1.55(c)

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 1 of 1

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

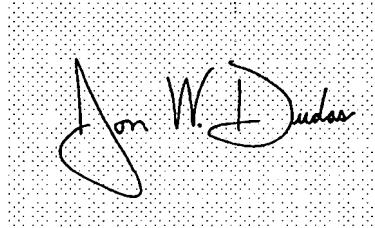
Title page.

Insert Item:

-- [30] Foreign Application Priority Data  
Feb 21, 1997 (GB) .....9703591.9 --.

Signed and Sealed this

Third Day of January, 2006

A handwritten signature in black ink, appearing to read "Jon W. Dudas", is placed over a dotted rectangular background.

JOHN W. DUDAS  
Director of the United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 1 of 6

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title Page.

Item [56] References Cited, U.S. PATENT DOCUMENTS: insert

-- 4,214,230	7/22/80	Fak et al.
4,218,582	8/19/80	Hellman et al.
4,259,720	3/31/81	Campbell
4,302,810	11/24/81	Bouricius et al.
4,305,059	12/8/81	Benton
4,321,672	3/23/82	Braun et al.
4,341,951	7/27/82	Benton
4,405,829	9/20/83	Rivest et al.
4,408,203	10/4/83	Campbell
4,423,287	12/27/83	Zeidler
4,442,345	4/10/84	Mollier et al.
4,453,074	6/5/84	Weinstein
4,467,139	8/21/84	Mollier
4,498,000	2/5/85	Decavale et al.
4,536,647	8/20/85	Atalla et al.
4,578,530	3/25/86	Zeidler
4,605,820	8/12/86	Campbell, Jr.
4,630,201	12/16/86	White
4,629,872	12/16/86	Hallberg
4,650,978	3/17/87	Hudson et al.
4,669,596	6/2/87	Capers et al.
4,705,211	11/10/87	Honda et al.
4,709,136	11/24/87	Watanabe
4,709,137	11/24/87	Yoshida
4,727,243	2/23/88	Savar
4,727,244	2/23/88	Nakano et al.
4,731,842	3/15/88	Smith
4,734,568	3/29/88	Watanabe
4,736,094	4/5/88	Yoshida
4,742,215	5/3/88	Daughters et al.
4,745,267	5/17/88	Davis et al.
4,746,788	5/24/88	Kawana
4,748,557	5/31/88	Tamada et al.
4,748,668	5/31/88	Shamir et al.
4,752,677	6/21/88	Nakano et al.
4,757,185	7/12/88	Onishi
4,757,543	7/12/88	Tamada et al.

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 2 of 6

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title Page (cont'd).

4,759,063	7/19/88	Chaum
4,759,064	7/19/88	Chaum
4,767,920	8/30/88	Kitta et al.
4,778,983	10/18/88	Ushikubo
4,785,166	11/15/88	Kushima
4,786,790	11/22/88	Kruse et al.
4,797,542	1/10/89	Hara
4,797,920	1/10/89	Stein
4,798,941	1/17/89	Watanabe
4,802,218	1/31/89	Wright et al.
4,803,347	2/7/89	Sugahara et al.
4,811,393	3/7/89	Hazard
4,816,653	3/28/89	Anderl et al.
4,816,654	3/28/89	Anderl et al.
4,825,052	4/25/89	Chemin et al.
4,831,245	5/16/89	Ogasawara
4,833,595	5/23/89	Iijima
4,839,504	6/13/89	Nakano
4,839,792	1/13/891	Iijima
4,849,614	7/18/89	Watanabe et al.
4,853,522	8/1/89	Ogasawara
4,853,961	8/1/89	Pastor
4,874,935	10/17/89	Younger
4,877,945	10/31/89	Fujisaki
4,877,947	10/31/89	Mori
4,879,747	11/7/89	Leighton et al.
4,887,234	12/12/89	Iijima
4,891,503	1/2/90	Jewell
4,891,506	1/2/90	Yoshimatsu
4,900,904	2/13/90	Wright et al.
4,906,828	3/6/90	Halpern
4,907,270	3/6/90	Hazard
4,926,480	5/15/90	Chaum
4,935,962	6/19/90	Austin
4,961,142	10/2/90	Elliott et al.
4,969,188	11/6/90	Schobi
4,977,595	12/11/90	Ohta et al.
4,984,270	1/8/91	LaBounty
4,985,615	1/15/91	Iijima

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 3 of 6

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title Page (cont'd).

4,987,593	1/22/91	Chaum
4,993,068	2/12/91	Piosenka et al.
4,995,081	2/19/91	Leighton et al.
4,996,711	2/26/91	Chaum
5,001,753	3/19/91	Davio et al.
5,003,594	3/26/91	Shinagawa
5,005,200	4/2/91	Fischer
5,010,239	4/23/91	Mita
5,012,074	4/30/91	Masada
5,012,076	4/30/91	Yoshida
5,016,274	5/14/91	Micali et al.
5,038,025	8/6/91	Kodera
5,068,894	11/26/91	Hoppe
5,093,862	3/3/92	Schwartz
5,097,115	3/17/92	Ogasawara et al.
5,120,939	6/9/92	Claus et al.
5,128,997	7/7/92	Pailles et al.
5,131,038	7/14/92	Puhl et al.
5,142,578	8/25/92	Matyas et al.
5,146,499	9/8/92	Geffrotin
5,148,481	9/15/92	Abraham et al.
5,161,231	11/3/92	Iijima
5,163,098	11/10/92	Dahbura
5,164,988	11/17/92	Matyas et al.
5,165,043	11/17/92	Miyahara et al.
5,166,503	11/24/92	Mizuta
5,175,416	12/29/92	Mansvelt et al.
5,180,901	1/19/93	Hiramatsu
5,191,193	3/2/93	Le Roux
5,191,608	3/2/93	Geronimi
5,200,999	4/6/93	Matyas et al.
5,201,000	4/6/93	Matyas et al.
5,202,922	4/13/93	Iijima
5,214,702	5/25/93	Fischer
5,224,162	6/29/93	Okamoto et al.
5,243,175	9/7/93	Kato
5,247,578	9/21/93	Pailles et al.
5,371,797	12/6/94	Bocinsky, Jr.
5,420,405	5/30/95	Chasek

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 4 of 6

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Title Page (cont'd).

5,473,690	12/5/95	Grimonprez et al.
5,485,520	1/16/96	Chaum et al.
5,511,121	4/23/96	Yacobi
5,517,011	5/14/96	Vandenengel
5,530,232	6/25/96	Taylor
5,534,857	7/9/96	Laing et al.
5,539,825	7/23/96	Akiyama et al.
5,542,081	7/30/96	Geronimi
5,544,246	8/6/96	Mandelbaum et al.
5,546,523	8/13/96	Gatto
5,557,516	9/17/96	Hogan
5,574,269	11/12/96	Mori et al.
5,578,808	11/26/96	Taylor
5,692,132	11/25/97	Hogan
5,699,528	12/16/97	Hogan
5,704,046	12/30/97	Hogan
5,705,798	1/6/98	Tarbox
5,708,780	1/13/98	Levergood et al.
5,715,314	2/3/98	Payne et al.
5,724,424	3/3/98	Gifford --

FOREIGN PATENT DOCUMENTS: insert

-- FR 2667171	1992	France
EP 0686947	1995	EP
WO 9116691	10/31/91	EP --

OTHER PUBLICATIONS: insert

-- Davies et al., "Security for Computer Networks: An Introduction to Data Security in Teleprocessing and Electronic Funds Transfer," John Wiley & Sons 1984 --

Drawings.

Figure 4, "1/O" (one/O) should read -- I/O -- (input/output)

UNITED STATES PATENT AND TRADEMARK OFFICE  
CERTIFICATE OF CORRECTION

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 5 of 6

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 1,

Line 8, "601046,543" should read -- 60/046,543 --

Column 2,

Line 59, "wilt" should read -- with --

Column 4,

Line 24, "A The" should read -- The --

Column 5,

Line 29, "mathematic" should read -- mathematical --

Column 7,

Line 50, "issuer\_product\_d." should read -- issuer\_product\_id. --

Line 56, "wish," should read -- wish --

Column 11,

Line 7, "tho" should read -- the --

Line 24, "s electively" should read -- selectively --; and "o n" should read -- on --

Line 28, "load ed" should read -- loaded --

Column 12,

Line 21, "2" should read -- 2 --

Line 25, "2" should read -- 2 --

Line 53, "cad's" should read -- card's --

Column 13,

Line 8, "ash" should read -- cash --

Column 14,

Line 17, "Cad" should read -- Card --

Column 15,

Line 52, "Personalization" should read -- personalization --

UNITED STATES PATENT AND TRADEMARK OFFICE  
**CERTIFICATE OF CORRECTION**

PATENT NO. : 6,317,832 B1  
DATED : November 13, 2001  
INVENTOR(S) : Everett et al.

Page 6 of 6

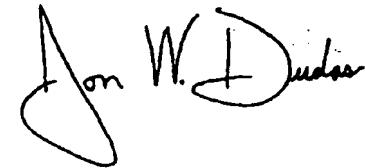
It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

Column 16.

Line 7, "locks" should read -- blocks --  
Line 24, ""on should read -- onto --  
Line 37, "using," should read -- using --  
Line 37, "key;" should read -- key; and --  
Line 52, "application;" should read -- application; and --

Signed and Sealed this

Twenty-seventh Day of July, 2004



JON W. DUDAS  
*Acting Director of the United States Patent and Trademark Office*

LEXSEE 66 FR 67087

FEDERAL REGISTER

Vol. 66, No. 249

Rules and Regulations

DEPARTMENT OF COMMERCE (DOC)

United States Patent and Trademark Office (USPTO)

37 CFR Part 1

[Docket No.: 010815207-1285-03]

RIN 0651-AB41

**Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications**

66 FR 67087

**DATE:** Friday, December 28, 2001

**ACTION:** Final rule.

---

To view the next page, type .np\* TRANSMIT.

To view a specific page, transmit p\* and the page number, e.g. p\*1

---

[\*67087]

**SUMMARY:** In implementing the provisions of the American Inventors Protection Act of 1999 related to the eighteen-month publication of patent applications, the United States Patent and Trademark Office (Office) revised the rules of practice related to requirements for claiming the benefit of a prior-filed application. The Office is now revising the time period for claiming the benefit of a prior-filed application in an application filed under the Patent Cooperation Treaty (PCT), revising the time period for filing an English language translation of a non-English language provisional application, and making other technical corrections to the rules of practice related to eighteen-month publication.

**EFFECTIVE DATE:** December 28, 2001.

**FOR FURTHER INFORMATION CONTACT:** Robert A. Clarke or Joni Y. Chang, Legal Advisors, Office of Patent Legal Administration, by telephone at (703) 308-6906, or by mail addressed to: Box Comments-Patents, Commissioner for Patents, Washington, DC 20231, or by facsimile to (703) 872-9399, marked to the attention of Robert A. Clarke.

**SUPPLEMENTARY INFORMATION:** The American Inventors Protection Act of 1999 was enacted into law on November 29, 1999. *See* Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999). The American Inventors Protection Act of 1999 contained a number of changes to title 35, United States Code, including provisions for the publication of pending applications for patent, with certain exceptions, promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code ("eighteen-

month publication"). The Office implemented the eighteen-month publication provisions of the American Inventors Protection Act of 1999 in a final rule published in September of 2000. *See Changes to Implement Eighteen-Month Publication of Patent* [\*67088] Applications, 65 FR 57023 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office 63 (Oct. 10, 2000) (final rule).

Section 4503(a) of the American Inventors Protection Act of 1999 amended 35 U.S.C. 119(b) to provide that no application for patent shall be entitled to a right of priority under 35 U.S.C. 119(a)-(d) unless a claim identifying the foreign application is filed at such time during the pendency of the application as required by the Office. Section 4503(b) of the American Inventors Protection Act of 1999 amended 35 U.S.C. 119(e) and 120 to provide that no application shall be entitled to the benefit of a prior-filed application unless an amendment containing the specific reference to the prior-filed application is submitted at such time during the pendency of the application as required by the Office. Section 4503 of the American Inventors Protection Act of 1999 also amended 35 U.S.C. 119 and 120 to permit the Office to establish procedures for accepting an unintentionally delayed claim for the benefit of a prior-filed application. Section 4503 of the American Inventors Protection Act of 1999 applies to applications filed under 35 U.S.C. 111 on or after November 29, 2000, and to applications entering the national stage after compliance with 35 U.S.C. 371 that resulted from international applications filed on or after November 29, 2000. *See* Pub. L. 106-113, § 4508, 113 Stat. at 1501A-566 through 1501A-567. This final rule amends 37 CFR 1.55 and 1.78 to: (1) Revise the requirements for claiming the benefit of a prior-filed application in an application filed under the PCT; (2) revise the time period and requirements for filing an English language translation of a non-English language provisional application; and (3) expressly indicate that the time period requirements which implement the provisions of § 4503 of the American Inventors Protection Act of 1999 do not apply to applications filed before November 29, 2000.

### Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 1, is amended as follows:

**Section 1.14:** Section 1.14(i)(2) is amended to correct its reference to "35 U.S.C. 154(d)(4) (formerly indicated as "35 U.S.C. 154(2)(d)(4)").

**Section 1.55:** Section 1.55(a)(1)(i) is amended such that the rules of practice expressly indicate that the time periods in § 1.55(a)(1)(i) do not apply in an application under 35 U.S.C. 111(a) if the application is: (1) an application for a design patent; or (2) an application filed before November 29, 2000. The Office indicated that the changes to § 1.55 (and § 1.78) to implement eighteen-month publication applied only to applications filed on or after November 29, 2000. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57024, 1239 Off. Gaz. Pat. Office at 63. The Office, however, has received enough inquiries about whether the time periods set forth in § 1.55(a)(1)(i) (and § 1.78(a)(2) and § 1.78(a)(5)) apply to particular applications that the Office has decided to place this information in § 1.55 (and § 1.78) itself.

Section 1.55(c) is amended to expressly indicate that a petition under § 1.55(c) to accept the delayed claim must also be accompanied by the claim (*i.e.*, the claim required by 35 U.S.C. 119(a)-(d) and § 1.55) for priority to the prior foreign application, unless previously submitted.

**Section 1.78:** Section 1.78(a)(1) is amended to make its provisions applicable to international applications designating the United States of America. The phrase "nonprovisional application" as used in the rules of practice means either an application filed under 35 U.S.C. 111(a) or an international application filed under 35 U.S.C. 363 that entered the national stage after compliance with 35 U.S.C. 371. *See* § 1.9(a)(3). Thus, provisions which apply only to a nonprovisional application (*e.g.*, the requirement in § 1.78(a)(2)(iii) for a specific reference in an application data sheet (§ 1.76) or the specification) do not apply to any international application that does not enter national stage processing under 35 U.S.C. 371. The specific reference requirements of 35 U.S.C. 119(e) and 120 are met in such an international application by a specific reference to the prior-filed application in the international application papers (*e.g.*, in the Request (PCT Rule 4.10 and § 1.434(d)(2)), or a correction or addition in accordance with PCT Rule 26 bis).

Section 1.78(a)(2) is amended to place its provisions in separate paragraphs (a)(2)(i) through (a)(2)(iv) for clarity. Section 1.78(a)(2) is also amended to make its provisions applicable to international applications designating the United States of America, and to set forth the time period for making a claim (providing the specific reference required by § 1.78(a)(2)(i)) for both an application filed under 35 U.S.C. 111(a) and an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371.

Specifically, if the later-filed application is an application filed under 35 U.S.C. 111(a), the specific reference required by § 1.78(a)(2)(i) must be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If, however, the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the specific reference required by § 1.78(a)(2)(i) must be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. This reference must, in any event, be submitted during the pendency of the later-filed application. The provisions relating to an application filed under 35 U.S.C. 111(a) do not change the time period for submitting a specific reference in such applications. The provisions relating to an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371, however, do change the time period for submitting a specific reference to any prior-filed application for which a benefit is claimed in such international applications in that the four-month period is measured from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) rather than the actual filing date of the international application under 35 U.S.C. 363.

Section 1.78(a)(2) is also amended to eliminate the requirement that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English. The Office is eliminating this requirement because: (1) The Office will not delay publication of the application if this requirement is not met; and (2) this information can be obtained from other sources.

Section 1.78(a)(2) is also amended such that the rules of practice expressly indicate that the time periods in § 1.78(a)(2)(ii) do not apply if the later-filed application is: (1) An application for a design patent; (2) an application filed under 35 U.S.C. 111(a) before November 29, 2000; or (3) a nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000. The Office indicated that the changes to § 1.78 to implement eighteen-month publication applied only to applications [\*67089] filed on or after November 29, 2000. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57024, 1239 Off. Gaz. Pat. Office at 63. The Office, however, has received enough inquiries about whether the time periods set forth in § 1.78 apply to particular applications that the Office has decided to place this information in § 1.78 itself.

Section 1.78(a)(2) is also amended to change the sentence "[t]he identification of an application by application number under this section is the specific reference required by 35 U.S.C. 120 to every application assigned that application number" to "[t]he identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number." That is, a continued prosecution application under § 1.53(d) (CPA) does not require any additional identification of or reference to the prior application (or any prior application assigned the application number of such application under § 1.53(d)) under 35 U.S.C. 120 and § 1.78(a)(2) other than the identification of the prior application in the request required by § 1.53(d) for a CPA. *See Changes to Patent Practice and Procedure*, 62 FR 53131, 53144 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 73 (Oct. 21, 1997) (final rule). The change to this provision clarifies that the other provisions of § 1.78(a)(2) (e.g., that the claim be in the application data sheet or the first sentence of the specification) remain applicable when an application under § 1.53(b) claims the benefit under 35 U.S.C. 120 of a continued prosecution application filed under § 1.53(d).

Section 1.78(a)(3) is amended to expressly indicate that a petition under § 1.78(a)(3) to accept the delayed claim must also be accompanied by the claim (*i.e.*, the reference required by 35 U.S.C. 120 and § 1.78(a)(2)) to the benefit of the prior-filed application, unless previously submitted. Section 1.78(a)(3) is also amended to change "paragraph (a)(2)" to paragraph "(a)(2)(ii)" for consistency with the changes to § 1.78(a)(2).

Section 1.78(a)(3) provides that if the reference required by 35 U.S.C. 120 and § 1.78(a)(2) of this section is presented in a nonprovisional application after the time period provided by § 1.78(a)(2)(ii), the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States may be accepted if the applicant files a petition to accept the delayed claim that is accompanied by: (1) the reference required by 35 U.S.C. 120 and § 1.78(a)(2) to the prior-filed application (unless previously submitted); (2) the surcharge set forth in § 1.17(t); and (3) a statement that the entire delay between the date the claim was due under § 1.78(a)(2)(ii) and the date the claim was filed was unintentional.

If an applicant includes a claim to the benefit of a prior-filed nonprovisional application or international application designating the United States elsewhere in the application but not in the manner specified in § 1.78(a)(2)(i) and (iii) (e.g., if the claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in § 1.78(a)(2)(ii), the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application within the time period set forth in § 1.78(a)(2)(ii). Of course, the applicant must still submit the claim in the manner specified in § 1.78(a)(2)(i) and (iii) (i.e., by an amendment in the first sentence of the specification or in an application data sheet) to have a proper claim under 35 U.S.C. 120 and § 1.78 to the benefit of a prior-filed application. If, however, an applicant includes such a claim elsewhere in the application and not in the manner specified in § 1.78(a)(2)(i) and (iii), and the claim is not recognized by the Office as shown by its absence on the filing receipt (e.g., if the claim is in a part of the application where priority or continuity claims are not conventionally located, such as the body of the specification), the Office will require a petition (and the surcharge under § 1.17(t)) to correct such claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application.

Section 1.78(a)(4) is amended to make its provisions applicable to international applications designating the United States of America.

Section 1.78(a)(5) is amended to place its provisions in separate paragraphs (a)(5)(i) through (a)(5)(iv) for clarity. Section 1.78(a)(5) is also amended to: (1) Make its provisions applicable to international applications designating the United States of America; (2) set forth the time period for making a claim (providing the specific reference required by § 1.78(a)(5)) for both an application filed under 35 U.S.C. 111(a) and an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371; and (3) change the time period and requirements for filing an English language translation of a non-English language provisional application.

Specifically, if the later-filed application is an application filed under 35 U.S.C. 111(a), the specific reference required by § 1.78(a)(5)(i) must be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If, however, the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the specific reference required by § 1.78(a)(5)(i) must be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. This reference must, in any event, be submitted during the pendency of the later-filed application. The provisions relating to an application filed under 35 U.S.C. 111(a) do not change the time period for submitting a specific reference in such applications. The provisions relating to an international application designating the United States of America which entered the national stage after compliance with 35 U.S.C. 371, however, do change the time period for submitting a specific reference to any prior-filed application for which a benefit is claimed in such international applications in that the four-month period is measured from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) rather than the actual filing date of the international application under 35 U.S.C. 363.

Section 1.78(a)(5) is also amended such that the rules of practice expressly indicate that the time periods in § 1.78(a)(5)(ii) do not apply if the later-filed application is: (1) an application filed under 35 U.S.C. 111(a) before November 29, 2000; or (2) a nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

Section 1.78(a)(5) is also amended to provide that if a provisional application was filed in a language other than [\*67090] English and an English-language translation of the provisional application and a statement that the translation is accurate were not previously filed in the provisional application or the nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application. Thus, § 1.78(a)(5) no longer provides that if a provisional application was filed in a language other than English, a claim to the benefit of such provisional application is waived if an English language translation of a non-English language provisional application is not submitted within the later of four months from the actual filing date of the nonprovisional application or sixteen months from the filing date of the prior-filed provisional application. In the event that the Office schedules an application that claims the benefit of a provisional application filed in a language other than English for publication without issuing a notice requir-

ing the applicant to file English-language translation of the non-English-language provisional application, the applicant should file the English-language translation of the non-English-language provisional application and a statement that the translation is accurate before the scheduled publication date. This change to § 1.78(a)(5) allows applicant to file an English-language translation of a non-English language provisional application either in the provisional application or in each nonprovisional application that claims the benefit of the provisional application.

Section 1.78(a)(5) is also amended to delete the term "copending," as 35 U.S.C. 119(e) no longer requires copendency between a nonprovisional application and a provisional application for the nonprovisional application to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e). 35 U.S.C. 119(e)(1) continues to require that any nonprovisional application claiming the benefit of a provisional application be filed within twelve months after the filing date of the provisional application (or the next succeeding business day if the date that is twelve months after the filing date of the provisional application falls on a Saturday, Sunday, or Federal holiday). *See Request for Continued Examination Practice and Changes to Provisional Application Practice*, 65 FR 50092, 50098 (Aug. 16, 2000), 1238 Off. Gaz. Pat. Office 13, 18-19 (Sept. 5, 2000) (final rule) (comment 2 and response).

Section 1.78(a)(6) is amended to expressly indicate that a petition under § 1.78(a)(6) to accept the delayed claim must also be accompanied by the claim (*i.e.*, the reference required by 35 U.S.C. 119(e) and § 1.78(a)(5)) to the benefit of the prior-filed provisional application, unless previously submitted. Section 1.78(a)(6) is also amended to change "paragraph (a)(5)" to paragraph "(a)(5)(ii)" for consistency with the changes to § 1.78(a)(5).

Section 1.78(a)(6) provides that if the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by § 1.78(a)(5)(ii), the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted if the applicant files a petition to accept the delayed claim that is accompanied by: (1) the reference required by 35 U.S.C. 119(e) and § 1.78(a)(5) to the prior-filed provisional application (unless previously submitted); (2) the surcharge set forth in § 1.17(t); and (3) a statement that the entire delay between the date the claim was due under § 1.78(a)(5)(ii) and the date the claim was filed was unintentional.

If an applicant includes a claim to the benefit of a prior-filed provisional application elsewhere in the application but not in the manner specified in § 1.78(a)(5)(i) and (iii) (*e.g.*, if the claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in § 1.78(a)(5)(ii), the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. This is because the application will have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application within the time period set forth in § 1.78(a)(5)(ii). Of course, the applicant must still submit the claim in the manner specified in § 1.78(a)(5)(i) and (iii) (*i.e.*, by an amendment in the first sentence of the specification or in an application data sheet) to have a proper claim under 35 U.S.C. 119(e) and § 1.78 to the benefit of a prior-filed provisional application. If, however, an applicant includes such a claim elsewhere in the application and not in the manner specified in § 1.78(a)(5)(i) and (iii), and the claim is not recognized by the Office as shown by its absence on a filing receipt (*e.g.*, if the claim is in a part of the application where priority or continuity claims are not conventionally located, such as the body of the specification), the Office will require a petition (and the surcharge under § 1.17(t)) to correct such claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application.

**Section 1.311:** Section 1.311(a) is amended to correct the parenthetical reference to "(§ 1.211(f))" to "(§ 1.211(e))."

**Section 1.434:** Section 1.434(d)(2) is amended by deleting the term "copending," as the prior national application may be a provisional application and 35 U.S.C. 119(e) no longer requires copendency for a nonprovisional application to claim the benefit of the filing date of a provisional application under 35 U.S.C. 119(e).

**Section 1.491:** The Office proposed amending § 1.491 such that the regulations set forth the current language of 35 U.S.C. 371(b) that defines when national stage commencement occurs. The Office will adopt that proposed change to § 1.491 in a separate final rule that implements an amendment to PCT Article 22.

#### Response to Comments

The Office published a notice proposing the above-mentioned changes to the rules of practice. *See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications*, 66 FR 46409 (Sept. 5, 2001), 1251 Off. Gaz. Pat. Office 16 (Oct. 2, 2001) (notice of proposed rulemaking). The Office re-

ceived seven written comments (from intellectual property organizations, patent practitioners, and the general public) in response to the notice of proposed rulemaking. The comments are available for public inspection at the Office of the Commissioner for Patents, located in Crystal Park 2, Suite 910, 2121 Crystal Drive, Arlington, Virginia, and are also posted on the Office's Internet Web site (address: <http://www.uspto.gov>).

Most of the comments expressed support for the proposed changes. None of the comments opposed the proposed changes, but several comments included additional suggestions. Those comments and the Office's responses follow (comments that generally support the proposed changes are not discussed): [\[\\*67091\]](#)

**Comment 1:** Several comments suggested that the Office make clear that the time period requirements in § 1.78(a)(2)(ii) and § 1.78(a)(5)(ii) (and resulting waiver if these time period requirements are not met) do not apply to applications filed before November 29, 2000. Another comment suggested that the change to § 1.78 be made retroactive to all applications filed on or after November 29, 2000.

**Response:** Sections 1.55 and 1.78 are now amended to expressly state that the time period requirements of § 1.55(a)(1)(i), § 1.78(a)(2)(ii) and § 1.78(a)(5)(ii) do not apply to applications filed before November 29, 2000. Therefore, there is no waiver of a benefit under 35 U.S.C. 119 or 120 for failure to comply with the time period requirements of § 1.55(a)(1)(i), § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii) in an application filed before November 29, 2000.

Except where the terms of § 1.55 and § 1.78 indicate that a provision of § 1.55 or § 1.78 applies only to applications filed on or after November 29, 2000 (*i.e.*, § 1.55(a)(1)(i), § 1.78(a)(2)(ii), and § 1.78(a)(5)(2)(ii)), the provisions of § 1.55 and § 1.78 as now amended are applicable to applications filed before, on, or after November 29, 2000. For example, both the elimination of the requirement that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (§ 1.78(a)(2)), and the more liberal time period and provisions for filing an English language translation of a non-English language provisional application (§ 1.78(a)(5)), apply to applications filed before, on, or after November 29, 2000. Sections 1.55 and 1.78 as now amended, however, provide that the time period requirements of § 1.55(a)(1)(i), § 1.78(a)(2)(ii) and § 1.78(a)(5)(ii) do not apply to applications filed before November 29, 2000.

**Comment 2:** Several comments suggested that § 1.78 be amended to state that, if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt or in the patent application publication.

**Response:** The Office has adopted the following practice: if an applicant includes a claim under § 1.78 to the benefit of a prior-filed application elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), respectively, the Office will not require a petition (and the surcharge under § 1.17(t)) to correct the claim if the information concerning the claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt (not as shown by its inclusion in the patent application publication). The reason for this practice is to avoid the situation in which an applicant is required to file a petition (and pay the surcharge under § 1.17(t)) even though the application was scheduled for publication on the basis of the information concerning the claim contained elsewhere in the application, but not in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii), within the time period set forth in § 1.78(a)(2)(ii). That is, whether an applicant is required to file a petition (and pay the surcharge under § 1.17(t)) to correct a claim that does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) is based upon the effect the informal claim has on the scheduling of the application for publication, and not whether the informal claim is ultimately included in the patent application publication.

The Office's goal is to encourage applicants to provide claims to the benefit of any prior-filed application in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii). Amending § 1.78 itself to expressly include the above-stated practice would give tacit approval to providing claim to the benefit of a prior-filed application in a manner that does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii). The commentors' proposed amendment to § 1.78 would have an effect contrary to the Office's goal of encouraging applicants to provide claims to the benefit of any prior-filed application in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii).

Finally, if a claim under § 1.78 does not comply with § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) (but is stated elsewhere in the application), such claim must eventually be presented in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) (*i.e.*, by an amendment in the first sentence of the specification or in an application data sheet) to be a proper claim under 35 U.S.C. 119(e) or 120 and § 1.78 to the benefit of a prior-filed application.

**Comment 3:** Several comments suggested that the Office should make it clear that if the requirements of § 1.78(a)(2)(ii) have been met, the applicant has not waived priority or continuity benefits even if the priority or continuity claim is not included in the patent application publication.

**Response:** If a claim under § 1.78 to the benefit of a prior-filed application is stated in the manner specified in § 1.78(a)(2)(i) and (iii) or § 1.78(a)(5)(i) and (iii) within the time period set forth in § 1.78(a)(2)(ii) or § 1.78(a)(5)(ii), the applicant has not waived the claim regardless of whether the Office includes the claim in the patent application publication. Nothing in § 1.78 suggests that the propriety of claim under § 1.78 is dependent upon its inclusion in the patent application publication.

**Comment 4:** Several comments suggested that the Office should provide applicants with the greatest possible flexibility in satisfying priority claim requirements, and should avoid adding technical requirements that may result in a loss of patent rights. The comments specifically suggested that since Office employees are familiar with checking the declaration for priority claims, § 1.78(a)(2)(iii) should be further amended to allow the reference required by § 1.78(a)(2)(i) to be included in the declaration.

**Response:** The Office allows applicants to provide claims under § 1.78 to the benefit of any prior-filed application either in the first line of the specification (where § 1.78 formerly required such a claim to be) or in an application data sheet (§ 1.76). Providing even this level of flexibility hinders the patent application publication and patent printing process when the specification and application data sheet (§ 1.76) contain conflicting information. Providing the oath or declaration under § 1.63 as an additional possible location for claims under § 1.78 to the benefit of any prior-filed application would result in confusion in situations in which: (1) the applicant has submitted multiple oaths or declarations under § 1.63; or (2) information submitted in the oath or declaration conflicts with information submitted in the specification or the application data sheet (§ 1.76). Providing the oath or declaration under § 1.63 as an additional possible location for claims to the benefit of any prior- [167092] filed application would also cause problems in the situation in which it is desirable to delete a claim to the benefit of a prior-filed application (for patent term purposes), in that a substitute oath or declaration not containing the claim would be necessary to eliminate a claim if such claim is made by a statement in the oath or declaration (§ 1.63).

**Comment 5:** Several comments suggested that the Office should take all steps necessary to ensure that all proper priority or benefit claims are included in the first paragraph of the patent application publication.

**Response:** The applicant and application information (*i.e.*, inventor names, including order, title, priority/benefit, assignee name) that is in the Office's Patent Application Locating and Monitoring (PALM) system at the time the application content is extracted from the Office's Patent Application Capture and Review (PACR) database for publication will be reflected on the front page of the patent application publication. Thus, if an application is filed without any priority or benefit claim, but a priority or benefit claim is subsequently submitted before the application content has been extracted for publication, the priority or benefit claim will be reflected on the front page of the patent application publication. The application content is currently extracted for publication approximately nine weeks before the projected publication date. The time period in § 1.55(a)(1), § 1.78(a)(2)(ii), and § 1.78(a)(5)(ii) for submitting a priority or continuity claim is four months from the actual filing date of the application or sixteen months from the filing date of the prior-filed application, which does not appear to expire until after the time at which application content is extracted for publication. As a practical matter, however, this time period will expire before the time at which application content is extracted for publication (and, as such, any timely priority or continuity claim should be entered into the Office's PALM system before the time at which application content is extracted for publication) because the failure to state a priority or continuity claim before a publication date is originally calculated will result in projected publication date that is later than the projected publication date would have been if such priority or continuity claim were taken into account.

If an untimely claim under § 1.78 to the benefit of a prior-filed application is accepted under § 1.78(a)(3) or § 1.78(a)(6) after the application content has been extracted for publication purposes, the Office plans to correct its electronic records relating to the patent application publication such that the claim under § 1.78 will be reflected on the Office's electronic records of the patent application publication (the eighteen-month publication process does not involve the creation of paper-based records).

Finally, while priority and continuity claims will be reflected on the front page of the patent application publication, continuity claims under § 1.78 will not additionally be stated on the first line of the specification unless the claim is included in the first line of the specification as originally filed or as filed in a copy of the application submitted by the Office electronic filing system under § 1.215(c). Specifically, claims under § 1.78 will not additionally be stated on the first line of the specification if the claim is included in a preliminary amendment to the specification (see § 1.215(c) (the patent application publication will not include any amendments, including preliminary amendments, unless applicant supplies a copy of the application containing the amendment pursuant to § 1.215(c))) or in an application data sheet (cf. *Changes to Implement the Patent Business Goals*, 65 FR 78958, 78959 (Dec. 18, 2000), 1242 Off. Gaz. Pat. Office 65 (Jan. 9, 2001) (final rule and correction) ("If continuity data is included in an application data sheet, but not in the first sentence of the specification, the continuity data to be set forth in the application data sheet will not be printed in the first line of the specification in the patent").

*Comment 6:* One comment questioned whether there is any mechanism for correcting the absence of a priority claim in an international application if an applicant files the international application designating the United States of America, but subsequently files a continuation application that claims the benefit of the international application and the international application never enters the national stage under 35 U.S.C. 371.

*Response:* The requirement that a claim to the benefit of a prior-filed provisional application, a prior-filed nonprovisional application, or a prior-filed international application designating the United States be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application does not apply to an international application that never entered the national stage under 35 U.S.C. 371. Therefore, to amend the later-filed international application to add a claim to the benefit of a prior-filed provisional application, a prior-filed nonprovisional application, or a prior-filed international application designating the United States, the applicant need only file a petition under § 1.182 to amend an abandoned application (the later-filed international application) with the claim to the benefit of a prior-filed application (regardless of whether the later-filed international application was filed in the United States Receiving Office).

*Comment 7:* Several comments supported the proposed change by which the Office would issue a notice in a nonprovisional application claiming the benefit of a non-English language provisional application that sets a time period within which the English translation must be filed, but noted that if the Office fails to issue such a notice and the applicant does not provide such a translation before publication, the burden will fall on applicants against whom the resulting patent application publication is cited as a reference to obtain a translation of the provisional application.

*Response:* The Office plans to check during the preexamination processing of a nonprovisional application to determine whether the nonprovisional application claims the benefit of a provisional application that was filed in a language other than English and, if so, whether an English-language translation of the provisional application was filed in the provisional application. If the nonprovisional application claims the benefit of a provisional application that was filed in a language other than English and no English-language translation of the provisional application was filed in the provisional application, the Office will issue a notice requiring the applicant to timely file an English-language translation and a statement that the translation is accurate. If the Office schedules an application that claims the benefit of a provisional application filed in a language other than English for publication without issuing a notice requiring the applicant to file an English-language translation of the non-English-language provisional application, the applicant should file the English-language translation of the non-English-language provisional application and a statement that the translation is accurate before the scheduled publication date.

The situation in which a patent application publication results from a nonprovisional application that claims the benefit of a provisional application that was filed in a language other than [§ 67093] English, and no English-language translation of the provisional application was filed in either the provisional application or the nonprovisional application, will not occur unless: (1) The Office fails to issue a notice during the preexamination processing of the nonprovisional application requiring the applicant to timely file an English-language translation of the provisional application; and (2) the applicant fails to provide the English-language translation of the non-English-language provisional application before the publication date of the patent application publication. Once this situation comes to the Office's attention, § 1.78(a)(5)(iv) as now amended provides that the Office may issue a notice requiring the applicant (in the nonprovisional application that resulted in the patent application publication) to provide an English-language translation of the non-English-language provisional application and a statement that the translation is accurate (the Office may also simply obtain its own English-language translation of the non-English-language provisional application if that appears to be the most convenient course of action). Failure to timely provide an English-language translation of the non-English-

language provisional application and a statement that the translation is accurate in reply to such a notice will result in abandonment in a pending nonprovisional application, and may jeopardize the claim to the benefit of the provisional application in any situation (since the requirements of § 1.78(a)(5) have not been complied with).

*Comment 8:* One comment questioned whether a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371 must include a reference under § 1.78 to the underlying international application.

*Response:* A reference under § 1.78 to the underlying international application is neither necessary nor appropriate in a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371. *See Manual of Patent Examining Procedure* § 1893.03(c) (8th ed. 2001) (a national stage application filed under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application).

*Comment 9:* One comment suggested that the surcharge for the unintentionally delayed submission of a priority claim was excessive.

*Response:* As indicated in the final rule to implement eighteen-month publication, this surcharge amount must be sufficient to provide an incentive for applicant to exercise care to ensure that any desired claim under 35 U.S.C. 119, 120, 121, or 365(a) or (c) is timely presented. As such, the surcharge amount tracks the fee amount for a petition to revive an unintentionally abandoned application (35 U.S.C. 41(a)(7)). *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57040, 1239 Off. Gaz. Pat. Office at 77 (comment 8 and response).

*Comment 10:* One comment noted that a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371 has already been published as an international application.

*Response:* As indicated in the final rule to implement eighteen-month publication, the International Bureau publication of an international application will not be included in the Office's patent application publication search database. The Office must (re)publish international applications that entered the national stage to place these applications into its patent application publication search database. The benefit gained by ensuring that these prior art documents will be included in the Office's patent application publication search database outweighs the cost of (re)publishing these applications. *See Changes to Implement Eighteen-Month Publication of Patent Applications*, 65 FR at 57045, 1239 Off. Gaz. Pat. Office at 82 (comment 47 and response).

## Classification

### *Administrative Procedure Act*

The changes in this final rule concern only the procedures for filing claims for the benefit of a prior-filed application under 35 U.S.C. 119(e) or 120, the procedures for filing an English language translation of a non-English language provisional application, and technical corrections to the provisions of §§ 1.78, 1.311, and 1.434. Because all of the changes relate to Office practices and procedures, prior notice and an opportunity for public comment was not required pursuant to 5 U.S.C. 553(b)(A) (or any other law), and thirty-day advance publication is not required pursuant to 5 U.S.C. 553(d) (or any other law). However, because the Office desired the benefit of public comment on this topic, the Office voluntarily accepted comments pursuant to a published notice proposing the above-mentioned changes.

### *Regulatory Flexibility Act*

As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 (or any other law), the analytical requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) are inapplicable. As such, the regulatory flexibility analysis is not required, and none has been provided. *See* 5 U.S.C. 603.

### *Executive Order 13132*

This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

### *Executive Order 12866*

This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

*Paperwork Reduction Act*

This final rule involves information collection requirements that are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (*44 U.S.C. 3501 et seq.*). The collections of information involved in this final rule have been reviewed and previously approved by OMB under the following control numbers: 0651-0021, 0651-0031, 0651-0032, and 0651-0033.

The title, description and respondent description of each of the information collections are shown below with an estimate of each of the annual reporting burdens. Included in each estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information.

*OMB Number:* 0651-0021.

*Title:* Patent Cooperation Treaty.

*Form Numbers:* PCT/RO/101, ANNEX/134/144, PTO-1382, PCT/IPEA/401, PCT/IB/328.

*Type of Review:* Regular submission (approved through December of 2003).

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Federal Agencies or Employees, Not-for-Profit Institutions, Small Businesses or Organizations.

*Estimated Number of Respondents:* 331,288.

*Estimated Time Per Response:* Between 15 minutes and 4 hours.

*Estimated Total Annual Burden Hours:* 401,083.

*Needs and Uses:* The information collected is required by the Patent Cooperation Treaty (PCT). The general purpose of the PCT is to simplify the [\*67094] filing of patent applications on the same invention in different countries. It provides for a centralized filing procedure and a standardized application format.

*OMB Number:* 0651-0031.

*Title:* Patent Processing (Updating).

*Form Numbers:* PTO/SB/08/21-27/30-32/35-37/42/43/61/62/63/64/67/68/91/92/ 96/97/PTO-2053/PTO-2055.

*Type of Review:* Regular submission (approved through October of 2002).

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

*Estimated Number of Respondents:* 2,247,389.

*Estimated Time Per Response:* 0.45 hours.

*Estimated Total Annual Burden Hours:* 1,021,941 hours.

*Needs and Uses:* During the processing of an application for a patent, the applicant/agent may be required or desire to submit additional information to the United States Patent and Trademark Office concerning the examination of a specific application. The specific information required or which may be submitted includes: Information Disclosure Statements; Terminal Disclaimers; Petitions to Revive; Express Abandonments; Appeal Notices; Petitions for Access; Powers to Inspect; Certificates of Mailing or Transmission; Statements under § 3.73(b); Amendments; Petitions and their Transmittal Letters; and Deposit Account Order Forms.

*OMB Number:* 0651-0032.

*Title:* Initial Patent Application.

*Form Number:* PTO/SB/01-07/13PCT/17-19/29/101-110.

*Type of Review:* Regular submission (approved through October of 2002).

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

*Estimated Number of Respondents:* 319,350.

*Estimated Time Per Response:* 9.35 hours.

*Estimated Total Annual Burden Hours:* 2,984,360 hours.

*Needs and Uses:* The purpose of this information collection is to permit the Office to determine whether an application meets the criteria set forth in the patent statute and regulations. The standard Fee Transmittal form, New Utility Patent Application Transmittal form, New Design Patent Application Transmittal form, New Plant Patent Application Transmittal form, Declaration, and Plant Patent Application Declaration will assist applicants in complying with the requirements of the patent statute and regulations, and will further assist the Office in the processing and examination of the application.

*OMB Number:* 0651-0033.

*Title:* Post Allowance and Refiling.

*Form Numbers:* PTO/SB/13/14/44/50-57; PTOL-85b.

*Type of Review:* Regular submission (approved through September of 2000).

*Affected Public:* Individuals or Households, Business or Other For-Profit Institutions, Not-for-Profit Institutions and Federal Government.

*Estimated Number of Respondents:* 135,250.

*Estimated Time Per Response:* 0.325 hour.

*Estimated Total Annual Burden Hours:* 43,893 hours.

*Needs and Uses:* This collection of information is required to administer the patent laws pursuant to title 35, U.S.C., concerning the issuance of patents and related actions including correcting errors in printed patents, refiling of patent applications, requesting reexamination of a patent, and requesting a reissue patent to correct an error in a patent. The affected public includes any individual or institution whose application for a patent has been allowed or who takes action as covered by the applicable rules. Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

#### **List of Subjects in 37 CFR Part 1**

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

For the reasons set forth in the preamble, 37 CFR part 1 is amended as follows:

#### **PART 1—RULES OF PRACTICE IN PATENT CASES**

1. The authority citation for 37 CFR Part 1 continues to read as follows:

*Authority:* 35 U.S.C. 2(b)(2).

2. Section 1.14 is amended by revising paragraph (i)(2) to read as follows:

#### **§ 1.14 -- Patent applications preserved in confidence.**

\* \* \* \* \*

(i) \* \* \*

(2) A copy of an English language translation of an international application which has been filed in the United States Patent and Trademark Office pursuant to 35 U.S.C. 154(d)(4) will be furnished upon written request including a showing that the publication of the application in accordance with PCT Article 21(2) has occurred and that the U.S. was designated, and upon payment of the appropriate fee (§ 1.19(b)(2) or § 1.19(b)(3)).

\* \* \* \* \*

3. Section 1.55 is amended by revising paragraphs (a)(1)(i) and (c) to read as follows:

**§ 1.55 – Claim for foreign priority.**

(a) \* \* \*

(1)(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

- (A) A design application; or
- (B) An application filed before November 29, 2000.

\* \* \* \* \*

(c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) must be accompanied by:

- (1) The claim under 35 U.S.C. 119(a)-(d) or 365(a) and this section to the prior [\*67095] foreign application, unless previously submitted;
- (2) The surcharge set forth in § 1.17(t); and
- (3) A statement that the entire delay between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

4. Section 1.78 is amended by revising paragraph (a) to read as follows:

**§ 1.78 – Claiming benefit of earlier filing date and cross references to other applications.**

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

- (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or
- (ii) Complete as set forth in § 1.51(b); or
- (iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or
- (iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
- (B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or
- (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

(i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed provisional application must be entitled to a filing date as set forth in § 1.53(c), and the basic filing fee set forth in § 1.16(k) must be paid within the time period set forth in § 1.53(g).

(5)(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four [\*67096] months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph (a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) If the prior-filed provisional application was filed in a language other than English and an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application or the later-filed nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application.

(6) If the reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(5)(ii) of this section, the claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application may be accepted during the pendency of the later-filed application if the reference identifying the prior-filed application by provisional application number was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application must be accompanied by:

(i) The reference required by 35 U.S.C. 119(e) and paragraph (a)(5) of this section to the prior-filed provisional application, unless previously submitted;

(ii) The surcharge set forth in § 1.17(t); and

(iii) A statement that the entire delay between the date the claim was due under paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

\* \* \* \* \*

5. Section 1.311 is amended by revising paragraph (a) to read as follows:

**§ 1.311 -- Notice of allowance.**

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

\* \* \* \* \*

6. Section 1.434 is amended by revising paragraph (d)(2) to read as follows:

**§ 1.434 – The request.**

\* \* \* \* \*

(d) \* \* \*

(2) A reference to any prior-filed national application or international application designating the United States of America, if the benefit of the filing date for the prior-filed application is to be claimed.

Dated: December 19, 2001.

**James. E. Rogan,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

[FR Doc. 01-31872 Filed 12-27-01; 8:45 am]

BILLING CODE 3510-16-P

**¶ 2.11 Application Must Be Copending With Parent**

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

**Examiner Note:**

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. Do not use this form paragraph for priority claims under 35 U.S.C. 119(e) to provisional applications.

If the \*>prior< application issues as a patent, it is sufficient for the \*>later-filed< application to be copending with it if the \*>later-filed< application is filed on the same date, or before the date that the patent issues on the \*>prior< application. Thus, the \*>later-filed< application may be filed under 37 CFR 1.53(b) while the \*>prior< is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. In view of the new patent publication process, it is anticipated that utility patents will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the \*>prior< application before the continuing application is filed.

If the \*>prior< application is abandoned, the \*>later-filed< application must be filed before the abandonment in order for it to be copending with the \*>prior application<. The term "abandoned," refers to abandonment for failure to prosecute (MPEP § 711.02), express abandonment (MPEP § 711.01), and abandonment for failure to pay the issue fee (37 CFR 1.316).

The expression "termination of proceedings" includes the situations when an application is abandoned or when a patent has been issued, and hence this expression is the broadest of the three.

After a decision by the Court of Appeals for the Federal Circuit in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the Court's certified copy of the decision by the U.S. Patent and Trademark Office. *Continental Can Company, Inc. v. Schuyler*, 168 USPQ 625 (D.D.C. 1970). There are several other situations in which proceedings are terminated as is explained in MPEP § 711.02(c).

When proceedings in an application are terminated, the application is treated in the same manner as an

abandoned application, and the term "abandoned application" may be used broadly to include such applications.

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor. The \*>later-filed< application may be referred to as a continuing application when the \*>prior< application is not a provisional application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. \*\* The statute is so worded that the \*>prior< application may contain more than the \*>later-filed application<, or the \*>later-filed< application may contain more than the \*>prior application<, and in either case the \*>later-filed< application is entitled to the benefit of the filing date of the \*>prior application< as to the common subject matter.

>A later-filed application which is not copending with the prior application (which includes those called "substitute" applications as set forth in MPEP § 201.09) is not entitled to the benefit of the filing date of the prior application. Therefore, prior art against the claims of the later-filed application is determined based on the filing date of the later-filed application. An applicant is not required to refer to such prior application(s) in an application data sheet or in the specification of the later-filed application, but is required to otherwise call the examiner's attention to the prior application if it or its contents or prosecution is material to patentability of the later-filed application as defined in 37 CFR 1.56(b).<

>

**III. < REFERENCE TO \*>PRIOR< APPLICATION>(S)<**

The third requirement of the statute is that the \*>later-filed< application must contain a specific reference to the \*>prior< application. This should appear as the first sentence of the specification following the title preferably as a separate paragraph (37 CFR 1.78(a)) and/or in an application data sheet (37 CFR 1.76). If the specific reference is only contained in the application data sheet, then the \*>benefit claim< information will be included on the front page of any patent or patent application publication, but will not be included in the first sentence of the specification. >When a benefit claim is submitted after the

filings of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

#### A. Reference to Prior Nonprovisional Applications

Except for benefit claims to the prior application in a continued prosecution application (CPA), benefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number, or by international application number and international filing date, and indicate the relationship between the applications. The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is "this application is a continuation of prior Application No. ---, filed ---." A benefit claim that merely states that "this application claims the benefit of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated. In addition, a benefit claim that merely states that "this application is a continuing application of Application No. ---, filed ---" does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing (i.e., continuation, divisional, or continuation-in-part) application, is not stated.<

A request for a \*\*>CPA< filed under 37 CFR 1.53(d) is itself the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. (Note: The CPA is assigned the same application number as the prior application.) In a CPA, a specific reference in the first sentence of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and may not be made. Any such reference will be deleted. No amendment in a CPA may delete the specific reference to the prior application assigned the same application number. A specific reference to an application not assigned the same application number, but relied on for benefit under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is required. Cross references to other

related applications not assigned the same application as the CPA may be made when appropriate.

When a nonprovisional application (other than a CPA) is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, a statement such as "This is a \*>divisional< (continuation, continuation-in-part) >application< of Application No. ---, filed ---" should appear as the first sentence of the description or in an application data sheet, except in the case of design applications where it should appear as set forth in MPEP § 1504.20. In the case of an application filed under 37 CFR 1.53(b) as a \*>divisional<, continuation or continuation-in-part of a CPA, there should be only one reference to the series of applications assigned the same application number, with the filing date cited being that of the original noncontinued application. Where a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application \* under 35 U.S.C. 371, a suitable reference would read "This application is a continuation of U.S. Application No. 08/---, filed ---, which was the National Stage of International Application No. PCT/DE95/---, filed ---." \*\*

>Any benefit claim that does not both identify a prior application by its application number and specify a relationship between the applications will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such benefit claim may not be recognized by the Office and may not be included on the filing receipt even if the claim appears in the first sentence of the specification or an application data sheet. As a result, publication of the application may not be scheduled as a function of the prior application's filing date. If the Office does not recognize a benefit claim under 35 U.S.C. 120 because it does not contain the required reference and the time period set forth in 37 CFR 1.78(a)(2)(ii) for submitting the required reference has expired, applicant must submit a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t) in order for the Office to accept the unintentionally delayed claim under 35 U.S.C. 120 since the application will not have been scheduled for publication on the basis of the prior application's filing date.

To specify the relationship between the applications, applicant must specify whether the application is a continuation, divisional, or continuation-in-part of the prior application. Note that the

terms are exclusive. An application cannot be, for example, both a continuation and a divisional or a continuation and a continuation-in-part of the same application. Moreover, if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications. For example, a statement that "this application claims the benefit of Application Nos. C, B, and A" or "this application is a continuing application of Application Nos. C, B, and A" is improper. Applicant instead must state, for example, that "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which is a continuation of Application No. A, filed ---.

#### *B. Reference to Prior Provisional Applications<*

When the nonprovisional application is entitled to an earlier U.S. effective filing date of one or more provisional applications under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application No. 60/ ---, filed ---" should appear as the first sentence of the description or in an application data sheet. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application No. 08/---, filed ---, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---." Status of nonprovisional parent applications (whether it is patented or abandoned) should also be included. If a parent application has become a patent, the expression, "Patent No. \_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application. In the case of design applications, it should appear as set forth in MPEP § 1504.20.

>The relationship (i.e., continuation, divisional, or continuation-in-part) is not required and should not be specified when a prior provisional application is being claimed under 35 U.S.C. 119(e). No relationship should be specified because whenever a priority claim

to a provisional application under 35 U.S.C. 119(e) is made, it is implicit that the relationship is "nonprovisional application of a provisional application." If a relationship between a prior provisional application and the nonprovisional application is submitted, it may be unclear whether the applicant wishes to claim the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) or 120. Thus, applicants seeking to claim the priority to a provisional application under 35 U.S.C. 119(e) should not state that the application is a "continuation" of a provisional application or that the application claims 35 U.S.C. 120 benefit to a provisional application. Although 35 U.S.C. 120 does not preclude a benefit claim to a provisional application, it is not recommended that applicants claim the benefit to a provisional application under 35 U.S.C. 120 since such a claim could have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. 154(a)(2).

#### *C. Benefit Claims to Multiple Prior Applications*

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant wishes that the pending application have the benefit of the filing date of the first filed application, applicant must, besides making reference to the intermediate application, also make reference to the first application. See *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968) and *Hovlid v. Asari*, 305 F. 2d 747, 134 USPQ 162 (9th Cir. 1962). The reference to the prior applications must identify all of the prior applications and indicate the relationship (i.e., continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must be made in each intermediate application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional

Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See *In re Henriksen*, 399 F.2d 253, 158 USPQ 224 (CCPA 1968).

A nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within 12 months from the filing date of the provisional application. Although an application that itself directly claims the benefit of a provisional application is not required to specify the relationship to the provisional application, if the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an intermediate nonprovisional application under 35 U.S.C. 120 that was filed within 12 months from the filing date of the provisional application and claimed the benefit of the provisional application, the intermediate application must be clearly identified as claiming the benefit of the provisional application so that the Office can determine whether the intermediate nonprovisional application was filed within 12 months of the provisional application and thus, whether the claim is proper. Applicant must state, for example, "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---." A benefit claim that merely states "this application claims the benefit of nonprovisional Application Nos. C and B, and provisional Application No. A" would be improper. Where the benefit of more than one provisional application is being claimed, the intermediate nonprovisional application(s) claiming the benefit of each provisional application must be indicated. Applicant must state, for example, "this application is continuation of Application No. D, filed ---, which is a continuation-in-part of Application No. C, filed ---, Application No. D claims the benefit of provisional Application No. B, filed ---, and Application No. C claims the benefit of provisional Application No. A, filed ---." If a benefit claim to a provisional application is submitted without an indication that an inter-

mediate application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the 12 month period or the relationship between each nonprovisional application is not indicated, the Office will not recognize such benefit claim and will not include the benefit claim on the filing receipt. Therefore, a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t) will be required if the intermediate application and the relationship of each nonprovisional application are not indicated within the period set forth in 37 CFR 1.78(a).

**D. *Reference Must Be Included in the Specification or an Application Data Sheet (ADS)***

The reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an ADS or the specification must contain or be amended to contain such reference in the first sentence following the title. If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt. If, however, a claim is not included in the first sentence of the specification or in an ADS and is not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition under 37 CFR 1.78(a) and the surcharge to correct the claim. The Office may not recognize any benefit claim where there is no indication of the relationship between the nonprovisional applications or no indication of the intermediate nonprovisional application that is directly claiming the benefit of the provisional application. Even if the Office has recognized a benefit claim by entering it into the Office's database and including it on applicant's filing receipt, the benefit claim is not a proper benefit claim under 35 U.S.C. 119(e) or 35 U.S.C. 120 and 37 CFR 1.78 unless the reference is included in an ADS or in the first sentence of the specification and all other requirements are met.

106-113 is effective as of November 29, 1999 and applies to any provisional applications filed on or after June 8, 1995 but has no effect on any patent which is the subject of litigation in an action commenced before November 29, 1999.

Use form paragraphs 2.09 and 2.11 to indicate copendency is required.

**¶ 2.11 Application Must Be Copending With Parent**

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

**Examiner Note:**

1. This form paragraph must be preceded by heading form paragraph 2.09.
2. Do not use this form paragraph for priority claims under 35 U.S.C. 119(e) to provisional applications.

If the first application issues as a patent, it is sufficient for the second application to be copending with it if the second application is filed on the same date, or before the date that the patent issues on the first application. Thus, the second application may be filed under 37 CFR 1.53(b) while the first is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. In view of the new patent publication process, it is anticipated that utility patents will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the first application before the continuing application is filed.

If the first application is abandoned, the second application must be filed before the abandonment in order for it to be copending with the first. The term "abandoned," refers to abandonment for failure to prosecute (MPEP § 711.02), express abandonment (MPEP § 711.01), and abandonment for failure to pay the issue fee (37 CFR 1.316).

The expression "termination of proceedings" includes the situations when an application is abandoned or when a patent has been issued, and hence this expression is the broadest of the three.

After a decision by the Court of Appeals for the Federal Circuit in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the Court's certified copy of the decision by the U.S. Patent and Trademark Office. *Continental*

*Can Company, Inc. v. Schuyler*, 168 USPQ 625 (D.D.C. 1970). There are several other situations in which proceedings are terminated as is explained in MPEP § 711.02(c).

When proceedings in an application are terminated, the application is treated in the same manner as an abandoned application, and the term "abandoned application" may be used broadly to include such applications.

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor. The second application may be referred to as a continuing application when the first application is not a provisional application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. As far as the right under the statute is concerned the name used is immaterial, the names being merely expressions developed for convenience. The statute is so worded that the first application may contain more than the second, or the second application may contain more than the first, and in either case the second application is entitled to the benefit of the filing date of the first as to the common subject matter.

**REFERENCE TO FIRST APPLICATION**

The third requirement of the statute is that the second (or subsequent) application must contain a specific reference to the first application. This should appear as the first sentence of the specification following the title preferably as a separate paragraph (37 CFR 1.78(a)) and/or in an application data sheet (37 CFR 1.76). If the specific reference is only contained in the application data sheet, then the priority information will be included on the front page of any patent or patent application publication, but will not be included in the first sentence of the specification.

A request for a continued prosecution application (CPA) filed under 37 CFR 1.53(d) is itself the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. (Note: The CPA is assigned the same application number as the prior application.) In a CPA, a specific reference in the first sentence of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not

required and may not be made. Any such reference will be deleted. No amendment in a CPA may delete the specific reference to the prior application assigned the same application number. A specific reference to an application not assigned the same application number, but relied on for benefit under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is required. Cross references to other related applications not assigned the same application as the CPA may be made when appropriate.

When a nonprovisional application (other than a CPA) is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date, a statement such as "This is a division (continuation, continuation-in-part) of Application No. ---, filed ---" should appear as the first sentence of the description or in an application data sheet, except in the case of design applications where it should appear as set forth in MPEP § 1504.20. In the case of an application filed under 37 CFR 1.53(b) as a division, continuation or continuation-in-part of a CPA, there should be only one reference to the series of applications assigned the same application number, with the filing date cited being that of the original noncontinued application. Where a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application filed under 35 U.S.C. 371, a suitable reference would read "This application is a continuation of U.S. Application No. 08/---, filed ---, which was the National Stage of International Application No. PCT/DE95/---, filed ---." In addition, if a nonprovisional application (including reissue) that is filed on or after November 29, 2000 claims benefit of an international application, the first sentence of the specification must be amended to indicate whether the international application was published in English under PCT Article 21(2). When the nonprovisional application is entitled to an earlier U.S. effective filing date of one or more provisional applications under 35 U.S.C. 119(e), a statement such as "This application claims the benefit of U.S. Provisional Application No. 60/---, filed ---, and U.S. Provisional Application No. 60/---, filed ---" should appear as the first sentence of the description or in an application data sheet. In addition, for an application which is claiming the benefit under 35 U.S.C. 120 of a prior application, which in turn claims the benefit of a provisional application under 35 U.S.C. 119(e), a suitable reference would read, "This application is a continuation of U.S. Application

No. 08/---, filed ---, now abandoned, which claims the benefit of U.S. Provisional Application No. 60/---, filed ---." Status of nonprovisional parent applications (whether it is patented or abandoned) should also be included. If a parent application has become a patent, the expression, "Patent No. \_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application. In the case of design applications, it should appear as set forth in MPEP § 1504.20. In view of this requirement, the right to rely on a prior application may be waived or refused by an applicant by refraining from inserting a reference to the prior application in the specification of the later one. If the examiner is aware of the fact that an application is a continuing application of a prior one, he or she should merely call attention to this in an Office action by using the wording of form paragraphs 2.15 or 2.16.

*¶ 2.15 Reference to Parent Application, 35 U.S.C. 119(e) or 120 Benefit*

If applicant desires priority under 35 U.S.C. [1] based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of

Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

**Examiner Note:**

1. In bracket 1, insert --119(e)-- or --120--.
2. In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a specific reference in the first sentence of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA application. 37 CFR 1.53(d)(2)(iv) and (d)(7).

***¶ 2.16 Reference to Copending Application***

It is noted that this application appears to claim subject matter disclosed in prior copending Application No. [1], filed [2]. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

**Examiner Note:**

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a specific reference in the first sentence of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA application. 37 CFR 1.53(d)(2)(iv) and (d)(7).

If the examiner is aware of a prior application he or she should note it in an Office action, as indicated above, but should not require the applicant to call attention to the prior application.

In an application filed under former 37 CFR 1.60 applicant, in the amendment canceling the nonelected claims, should include directions to enter "This is a division (continuation) of application No. ...., filed ...." as the first sentence. Where the applicant has inadvertently failed to do this the wording of form paragraph 2.17 should be used. Where the application filed under former 37 CFR 1.60 is otherwise ready for allowance, the examiner should insert the quoted sentence by examiner's amendment.

Applications are sometimes filed with a division, continuation, or continuation-in-part oath or declaration, in which the oath or declaration refers back to a prior application. If there is no reference in the specification of an application filed under former 37 CFR 1.60, in such cases, the examiner should merely call attention to this fact in his or her Office action, utilizing the wording of form paragraph 2.17.

***¶ 2.17 Reference in Continuation/Divisional Applications Under Former 37 CFR 1.60***

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a [1] of Application No. [2], filed [3]." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

**Examiner Note:**

1. In bracket 1, insert either --division-- or --continuation--.
2. Use only in former 37 CFR 1.60 applications. For File Wrapper Continuing applications under former 37 CFR 1.62, use form paragraph 2.28.
3. Do not use if the prior application is a provisional application.
4. Do not use if the application is a continued prosecution application (CPA) filed under 37 CFR 1.53(d).

Where the applicant has inadvertently failed to make a reference to the parent application in an application filed under former 37 CFR 1.60 or 1.62 which is otherwise ready for issue, the examiner should insert the required reference by a formal examiner's amendment.

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant desires that the pending application have the benefit of the filing date of the first filed application he or she must, besides making reference to the

intermediate application, also make reference to the first application. See *Hovlid v. Asari*, 305 F. 2d 747, 134 USPQ 162 (9th Cir. 1962); and *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 160 USPQ 177 (7th Cir. 1968).

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See *In re Henriksen*, 399 F2.d 253, 158 USPQ 224 (CCPA 1968).

A second application which is not copending with the first application, which includes those called substitutes in MPEP § 201.09, is not entitled to the benefit of the filing date of the prior application and the bars to the grant of a patent are computed from the filing date of the second application. An applicant is not required to refer to such applications in an application data sheet or in the specification of the later filed application, but is required to otherwise call the examiner's attention to the earlier application if it or its contents or prosecution are material as defined in 37 CFR 1.56(b). If the examiner is aware of such a prior abandoned application he or she should make a reference to it in an Office action in order that the record of the second application will show this fact.

If an applicant refers to a prior noncopending abandoned application in the specification or in an application data sheet, the manner of referring to it should make it evident that it was abandoned before filing the second.

For notations to be placed on the file wrapper in the case of continuing applications, see MPEP § 202.02 and § 1302.09.

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet (no supplemental declaration is necessary) to delete any references to prior applications. In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), no

amendment may delete the specific reference to a prior application assigned the same application number. (Note: In the CPA, the request is the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. Further, in a CPA, a specific reference in the first sentence of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and should not be made.) Upon entry of the amendment, the examiner must return the application to the Office of Initial Patent Examination (OIPE), accompanied by a completed OIPE Data Base Routing Slip, for correction of the file wrapper label and for updating the PALM data base. For 09/ series applications, it will not be necessary to forward the application to OIPE for correction of the parent application data in PALM. The correction or entry of the data in the PALM data base can be made by technical support staff of the TC. Upon entry of the data, a new PALM bib-data sheet should be printed and placed in the file wrapper. See also MPEP § 707.05 and § 1302.09.

#### SAME INVENTOR OR INVENTORS

The statute also requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. 119(e) or 120 be filed by an inventor or inventors named in the previously filed application or provisional application.

#### TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT 37 CFR 1.78(a)(2) AND (a)(5))

The time period requirement under 37 CFR 1.78(a)(2) and (a)(5) is only applicable to utility or plant applications filed on or after November 29, 2000.

The American Inventors Protection Act of 1999 (AIPA), Public Law 106-113, amended 35 U.S.C. 119 and 120 to provide that the Office may set a time period for the filing of benefit claims and establish procedures to accept an unintentionally delayed benefit claim. The Office has implemented these statutory changes, in part, by amending 37 CFR 1.78 to include: (A) a time period within which a benefit claim to a prior nonprovisional or provisional application must be stated or it is considered waived; and (B) provisions for the acceptance of the unintentionally

## **United States Patent and Trademark Office OG Notices: 18 March 2003**

### **Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c)**

**Summary:** This notice clarifies how benefit claims under 35 U.S.C. 119(e), 120, 121 and 365(c) must be presented in applications in order to be in compliance with the relevant statute and patent regulations, and accepted by the United States Patent and Trademark Office (Office).

#### **35 U.S.C. 120 Benefit Claims**

Benefit claims under 35 U.S.C. 120 must include a specific reference to the earlier filed (nonprovisional) application for which a benefit is sought. A "specific reference" requires: (1) the identification of the prior (nonprovisional) application by application number; and (2) an indication of the relationship between the nonprovisional applications, except for the benefit claim to the prior application in a continued prosecution application (CPA). The relationship between any two nonprovisional applications will be an indication that the later-filed nonprovisional application is either a continuation, divisional, or continuation-in-part of the prior-filed nonprovisional application. When there are benefit claims to multiple prior nonprovisional applications (e.g., a string of prior nonprovisional applications), the relationship must include an identification of each nonprovisional application as either a continuation, divisional, or continuation-in-part application of a specific prior nonprovisional application for which a benefit is claimed. The identification is needed in order to be able to verify if copendency exists throughout the entire chain of prior nonprovisional applications.

#### **35 U.S.C. 119(e) Benefit Claims**

Benefit claims under 35 U.S.C. 119(e) must include a specific reference to the earlier filed provisional application for which a benefit is sought. A specific reference in this situation, however, only requires identification of the prior provisional application by the application number. No relationship between the subject nonprovisional application and the prior provisional application should be specified. If the subject nonprovisional application was not filed within twelve months of the filing date of the provisional application, the subject application must also include a benefit claim under 35 U.S.C. 120 to an intermediate prior nonprovisional application that was filed within twelve months of the filing date of the provisional application. Therefore, in addition to the identification of the provisional application, the proper benefit claim for this situation must also identify the intermediate prior nonprovisional application that is directly claiming the benefit of the provisional application, and indicate the relationship between the nonprovisional applications (e.g., an indication that the subject application is a continuation of the intermediate prior nonprovisional application).

#### **Statement of the Problem**

**ENCLOSURE 8**

**AMENDED PETITION UNDER 37 CFR §1.55(c)**

**09/932,013**

Background: Some applicants have been submitting patent applications which include, or are amended to include, at the beginning of the specification, a statement that benefits are claimed under 35 U.S.C. 119(e) and/or 120 to prior applications, followed by a listing of many prior nonprovisional and provisional applications. The listings do not indicate: (1) the specific relationship (i.e., continuation, divisional, or continuation-in-part) between the nonprovisional applications, as required by 37 CFR 1.78(a)(2)(i); and/or (2) each nonprovisional application which is directly claiming priority to a provisional application. Without such information, the Office does not have sufficient information to enter the benefit claims into the Office's computer database.

When entering benefit claims for an application into the Office's database, the relationship (i.e., continuation, divisional or continuation-in-part) between the nonprovisional applications is required. Further, the system will not accept any benefit claim to a provisional application if the provisional application was filed more than twelve months prior to the filing date of the subject application, unless the applicant clearly identifies, and claims the benefit of, a prior nonprovisional application that was filed within twelve months of the filing date of the provisional application. Accordingly, if benefit claims are presented without all the required information, the Office will not be able to enter such benefit claims into the Office's database, the filing receipt will not reflect the prior application(s), and the projected publication date will not be calculated as a function of an earlier application's filing date.

The specific relationships between (each of) the nonprovisional applications in a chain of nonprovisional applications are also important because such information will be printed in the application publication, and/or patent. Furthermore, the designation of an application as a continuation (rather than as a continuation-in-part) is an indication that the entire invention claimed in an application has support in the prior application, whereas the designation of an application as a continuation-in-part is an indication that the claimed invention is not entirely supported by the prior application. Thus, the specific relationship between nonprovisional applications in a chain of benefit claims, and the indication of the specific nonprovisional application(s) that is directly claiming the benefit of a provisional application, will provide the information that is needed by examiners and the public in order to determine the effective prior art date of the application publication, or patent, under 35 U.S.C. 102(e).

When benefit claims are required to, but do not, include: (1) an identification of (all) intermediate benefit claims, and/or (2) the relationship between nonprovisional applications, the Office may not be able to publish applications promptly after the expiration of a period of eighteen months from the earliest filing date for which a benefit is sought under title 35, United States Code (eighteen-month publication), nor have the accuracy desired of such benefit claims in application publications. Further, the objection (by the Office), correction (by applicant), and review/entry of changes (by the Office) cycle for non-compliant benefit claims is a burdensome effort on both applicants and the Office that can be totally avoided if such benefit claims are properly submitted the first time. Accordingly, it is hoped that applicants will submit benefit claims with all the required information as set forth in this notice and, correspondingly, avoid submitting non-compliant benefit claims that leads to extra work for both the Office and applicants.

#### Procedures for Making Proper Benefit Claims

**Part I: Reference to Prior Nonprovisional Application(s)  
Per 37 CFR 1.78(a)(2)(i) Must Include Identification of, and  
Relationship Between, Applications**

35 U.S.C. 120 provides that no application shall be entitled to the benefit of an earlier filed application unless it contains, or is amended to contain, a specific reference to the earlier filed application. The specific reference required by 35 U.S.C. 120 is the reference required by 37 CFR 1.78(a)(2). 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application that claims the benefit of one or more prior-filed copending nonprovisional applications, or international applications designating the United States, must contain, or be amended to contain, a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number), or international application number and international filing date, and indicating the relationship of the applications. 37 CFR 1.78(a)(2)(iv) also provides that a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) is the specific reference required under 35 U.S.C. 120 to the prior-filed application. Therefore, except for the benefit claim to the prior-filed application in a CPA, benefit claims under 35 U.S.C. 120, including claims under 35 U.S.C. 121 and 365(c), must not only identify the earlier application by application number, or by international application number and international filing date, but they must also indicate the relationship between the applications.

**Examples**

The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/ - , filed - ." A benefit claim that merely states: "This application claims the benefit of Application No. 10/ - , filed - ." does not comply with 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated. In addition, a benefit claim that merely states: "This application is a continuing application of Application No. 10/ - , filed - ." does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. It is also noted that the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. An example of a proper benefit claim of a prior national stage of an international application is "This application is a continuation of U.S. Application No. X, which is the National Stage of International Application No. PCT/US - / - , filed - ." For additional examples of proper benefit claims, see Manual of Patent Examining Procedure (8th ed., August 2001) (MPEP), Section 201.11, Reference to First Application. Section 201.11 of the MPEP will be revised in the upcoming revision to reflect the clarification made in this notice about the required manner of making proper claims for the benefit of prior nonprovisional and provisional applications.

As stated previously, to specify the relationship between the nonprovisional applications, applicant must specify whether the subject application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. Note that the terms are exclusive. An application cannot be, for example, both a continuation

and a divisional, or a continuation and a continuation-in-part, of the same parent application. Moreover, if the benefit of more than one nonprovisional parent application is claimed, the relationship must include an identification of each nonprovisional application as a continuation, divisional, or continuation-in-part application of the immediate prior nonprovisional application for which a benefit is claimed in order to establish co-pendency throughout the entire chain of prior-filed parent nonprovisional applications. For example, the following two statements are improper: "This application claims the benefit of Application Nos. C, B, and A." and "This application is a continuing application of Application Nos. C, B, and A." On the other hand, the following statement is proper and acceptable: "This application is a continuation of Application No. C, filed - , which is a continuation of Application No. B, filed - , which is a continuation of Application No. A, filed - ."

#### Sanctions for Making Improper Benefit Claims to Nonprovisional Applications

Any benefit claim under 35 U.S.C. 120, 121 or 365(c) that does not identify a prior application and also specify a relationship between each of the applications will not be in compliance with 37 CFR 1.78(a)(2)(i), and will not be considered to contain a specific reference to a prior application as required by 35 U.S.C. 120. Such a benefit claim will not be recognized by the Office and will not be included on the filing receipt for the application, even if the claim appears in the first sentence of the specification or an application data sheet (37 CFR 1.76), because the Office does not have sufficient information to enter the benefit claim into the Office's database. As a result, publication of the application will not be scheduled as a function of the prior application's filing date. The Office plans to notify applicants on, or with, the filing receipt that a benefit claim may not have been recognized because it did not include the proper reference. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Since the filing receipt and the notification will usually be provided to the applicant shortly after the filing of the application, applicants should have sufficient opportunity to submit the proper benefit claims within the time period set in 37 CFR 1.78(a)(2)(ii) and thus avoid the need to submit a petition under 37 CFR 1.78(a)(3) and the surcharge set forth in 37 CFR 1.17(t). Failure to timely submit the reference required by 37 CFR 1.78(a)(2)(i) is considered a waiver of any benefit claim under 35 U.S.C. 120, 121 or 365(c) unless a petition to accept an unintentionally delayed claim under 37 CFR 1.78(a)(3), the surcharge set forth in 37 CFR 1.17(t), and the required reference, including the relationship of the applications (unless previously submitted) are filed. For example, if a benefit claim is submitted without the specific relationship between the nonprovisional applications before the expiration of the period, and the specific relationship between the nonprovisional applications is subsequently submitted after the expiration of the period, a petition and the surcharge would be required.

#### Part II: Reference to Prior Provisional Application(s) Per 37 CFR 1.78(a)(5)(i) Should Only Include Identification of Prior Provisional Application(s)

When the domestic benefit of a prior provisional application is being claimed under 35 U.S.C. 119(e), however, the relationship between the two applications should not be specified. 35

U.S.C. 119(e) provides that a nonprovisional application claiming the benefit of a provisional application must be filed within twelve months of the provisional application and must contain, or be amended to contain, a specific reference to the provisional application. The specific reference required by 35 U.S.C. 119(e) is the reference required by 37 CFR 1.78(a)(5). 37 CFR 1.78(a)(5)(i) requires that any nonprovisional application, or international application designating the United States, claiming the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application identifying it by provisional application number. No relationship should be specified whenever a claim for the benefit of a provisional application under 35 U.S.C. 119(e) is made.

If a relationship between a nonprovisional application and a prior provisional application is submitted, however, it may be unclear whether applicant wishes to claim the domestic benefit of the provisional application under 35 U.S.C. 119(e), or the benefit of an earlier application's filing date under 35 U.S.C. 120. Thus, applicants seeking to claim the domestic benefit of a provisional application under 35 U.S.C. 119(e) should not state that the application is a "continuation" of a provisional application, nor should it be stated that the application claims benefit under 35 U.S.C.

120 of a provisional application. If such a claim is submitted in an application transmitted to the Office other than through the Electronic Filing System, it will be entered into the Office computer system as a claim to the "benefit" of the provisional application. Although 35 U.S.C. 120 does not preclude a benefit claim to a provisional application (that is, one could obtain the benefit under 35 U.S.C. 120 of a prior filed provisional application), such a benefit claim under 35 U.S.C. 120 is not recommended as such a claim may have the effect of reducing the patent term, as the term of a patent issuing from such an application may be measured from the filing date of the provisional application pursuant to 35 U.S.C. 154(a)(2). Instead, applicants should state "This application claims the benefit of U.S. Provisional Application No. 60/ - , filed - ", or "This application claims the benefit of U.S. Provisional Application No. 60/ - , filed - , and U.S. Provisional Application 60/ - , filed - ." See MPEP 201.11, Reference to First Application (8th ed., August 2001).

**Part III: If Benefit is Claimed of a Prior Provisional Application Which was Filed More Than One Year Before the Subject Application, Then Each Prior Nonprovisional Application(s) Claiming Benefit of the Provisional Must be Specified**

Any nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within twelve months from the filing date of the provisional application. As noted above, an application that itself directly claims the benefit of a provisional application should identify, but not specify the relationship to, the provisional application. If the subject nonprovisional application is not filed within the twelve month period, however, it still may claim the benefit of the provisional application via an intermediate nonprovisional application under 35 U.S.C. 120. The intermediate nonprovisional application must have been filed within twelve months from the filing date of the provisional application and the intermediate nonprovisional application must have claimed the benefit of the provisional application. Further, it must be clearly indicated that the intermediate nonprovisional application is

claiming the benefit under 35 U.S.C. 119(e) of the provisional application. This identification of the intermediate nonprovisional application is necessary so that the Office can determine whether the intermediate nonprovisional application was filed within twelve months of the filing date of the provisional application, and thus, whether the benefit claim is proper.

#### Examples

Applicant should state such a benefit claim as follows: "This application is a continuation of Application No. C, filed - , which is a continuation of Application No. B, filed - , which claims the benefit of U.S. Provisional Application No. A, filed - ." A benefit claim that merely states "This application claims the benefit of nonprovisional Application No. C, filed - , nonprovisional Application No. B, filed - , and provisional application No. A, filed - " would be improper where the subject application was not filed within twelve months of the provisional application.

Where the benefit of more than one provisional application is being claimed, the intermediate nonprovisional application(s) claiming the benefit of each provisional application must be clearly indicated. Applicant should state, for example, "This application is continuation of Application No. D, filed - , which is a continuation-in-part of Application No. C, filed - , Application No. D claims the benefit of U.S. Provisional Application No. B, filed - , and Application No. C claims the benefit of U.S. Provisional Application No. A, filed - ." An example of a proper benefit claim of a prior national stage of an international application, which claims the priority to a provisional application, is "This application is a continuation of U.S. Application No. Y, which is the National Stage of International Application No. PCT/US - / - , filed - , which claims the benefit under 35 U.S.C. 119(e) of U.S. Provisional Application X, filed - ."

#### Sanctions for Making Improper Benefit Claims to Provisional Applications

If a benefit claim to a provisional application is submitted without an indication that an intermediate nonprovisional application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the twelve month period, or the relationship between nonprovisional applications is not indicated, the Office will not have sufficient information to enter the benefit claim into the computer database. Therefore, the Office will not recognize such a benefit claim, and will not include the benefit claim on the filing receipt. The Office plans to notify applicants on, or with, the filing receipt that a benefit claim may not have been recognized because information regarding the intermediate nonprovisional application(s) and/or the relationship between each nonprovisional application have not been provided. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Since the filing receipt and the notification will usually be provided to the applicant shortly after the filing of the application, applicants should have sufficient opportunity to submit the proper benefit claims within the time period set in 37 CFR 1.78(a) and thus avoid the need to submit a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t). Failure to timely submit the reference required by 37 CFR 1.78(a) is considered a waiver of any benefit claim under 35 U.S.C. 119(e),

120, 121 or 365(c) unless a petition under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), identification of the intermediate nonprovisional application which claims the benefit to the provisional application, and the relationship between each nonprovisional application are filed.

**Part IV: Office Practice to Not Require Petition and Surcharge if Benefit Claim is Not Present in the Proper Place But is Recognized By Office Continues But Applicants Are Advised That Proper Reference Must be Presented**

The reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title. Previously, the Office indicated that if an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt. If, however, a claim is included elsewhere in the application and not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition and the surcharge to correct the claim. See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication Provisions, 66 Fed. Reg. 67087, 67089-90 (Dec. 28, 2001). The Office will continue to follow this practice.

**Sanctions for Making Improper Benefit Claims**

Applicants are simply being advised by this notice that the Office will not recognize any benefit claim where there is no indication of the relationship between the nonprovisional applications, or no indication of the intermediate nonprovisional application that is directly claiming the benefit of a provisional application. Applicants are also reminded that, even if the Office has recognized a benefit claim that includes the proper reference by entering it into the Office's database and including it on applicant's filing receipt, the benefit claim is not a proper benefit claim under 35 U.S.C. 119(e) and/or 35 U.S.C. 120, and 37 CFR 1.78, unless the reference is included in an application data sheet, or the first sentence of the specification, and all other requirements are met.

**Part V: Correcting or Adding a Benefit Claim After Filing**

The Office will not grant a request for a corrected filing receipt to include a benefit claim unless a proper reference to the prior application(s) is included in the first sentence of the specification, or an application data sheet, within the time period required by 37 CFR 1.78(a). Any request for corrected filing receipt to include a corrected or added benefit claim must be submitted within the time period required by 37 CFR 1.78(a) and be accompanied by an amendment to the specification, or an application data sheet. If the proper reference was previously submitted, a copy of the amendment, the first page of the specification, or the application data sheet, containing the claim should be included with the request for corrected filing receipt. The Office plans to notify applicants on, or with, the

filings receipt that a benefit claim may not have been recognized because it did not include the proper reference. Applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Since the filing receipt and the notification will usually be provided shortly after the filing of the application, applicants should have sufficient opportunity to submit the proper benefit claims within the time period set in 37 CFR 1.78(a) and thus avoid the need to submit a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t). Therefore, applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition and the surcharge.

When an unintentionally delayed benefit claim is submitted with a petition under 37 CFR 1.78(a) and the surcharge set forth in 37 CFR 1.17(t), the benefit claim must include a proper reference to the prior application(s) in order for the petition to be granted. The reference to the prior application(s) must include: (1) the relationship between nonprovisional applications (i.e., continuation, divisional, or continuation-in-part), and (2) the indication of any intermediate application that is directly claiming the benefit of a provisional application, in order to establish copendency throughout the entire chain of prior applications.

Applicants are also reminded that, if an amendment to the specification, or an application data sheet (ADS), is submitted in an application under final rejection, the amendment or ADS must be in compliance with 37 CFR 1.116. The amendment or ADS filed in an application under final rejection will not be entered as a matter of right. See MPEP 714.12 and 714.13. Therefore, applicants should consider filing a request for continued examination (RCE) (including fee and submission) under 37 CFR 1.114 with the petition to accept an unintentionally delayed benefit claim, the surcharge, and an amendment that adds the proper reference to the first sentence of the specification or an ADS.

#### Part VI: Each Intermediate Prior Application Must Have Proper Reference

If the benefit of more than one prior application is claimed, applicant should also make sure that the proper references are made in each intermediate nonprovisional application in the chain of prior applications. If an applicant desires, for example, the following benefit claim: "This application is a continuation of Application No. C, filed - , which is a continuation of Application No. B, filed - , which claims the benefit of U.S. Provisional Application No. A, filed - , " then Application No. C must include a benefit claim containing a reference to Application No. B and provisional Application No. A, and Application No. B must include a benefit claim containing a reference to provisional Application No. A.

#### Part VII: Adding an Incorporation-By-Reference Statement in a Benefit Claim is Not Permitted After Filing

An incorporation-by-reference statement added after the filing date of an application is not permitted because no new matter can be added to an application after its filing date. See 35 U.S.C. 132(a). If an incorporation-by-reference statement is included in an amendment to the specification to add a benefit claim after the filing date of the application, the amendment would not be proper. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation-by-reference statement of the prior application. See *Dart Industries v. Banner*, 636 F.2d 684,

207 USPQ 273 (C.A.D.C. 1980). Therefore, the Office will not grant a petition to accept a benefit claim that includes an incorporation-by-reference statement of a prior application, unless the incorporation-by-reference statement was submitted on filing of the application.

Inquiries regarding this notice should be directed to Eugenia A. Jones or Joni Y. Chang, Legal Advisors, Office of Patent Legal Administration, by telephone at (703) 305-1622.

February 24, 2003

STEPHEN G. KUNIN  
Deputy Commissioner for  
Patent Examination Policy



## United States Patent and Trademark Office

## EMERGENCIES

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Related Notices > **USPS Interruptions**

### UNITED STATES POSTAL SERVICE INTERRUPTIONS

#### UNITED STATES POSTAL SERVICE INTERRUPTION AND EMERGENCY

The United States Postal Service (USPS) has informed the United States Patent and Trademark Office (USPTO) that as a result of the tragic event in New York City on September 11, 2001, all post offices in the borough of Manhattan are closed on September 12, 2001. These post offices will remain closed until further notice.

The USPTO is designating the interruption in the service of the USPS in the borough of Manhattan as a postal service interruption and an emergency within the meaning of 35 U.S.C. 21(a). Accordingly, the USPTO will consider the provisions of 37 C.F.R. 1.6(e) as now in effect. As soon as the USPTO receives further information from the USPS as to when postal services in the borough of Manhattan will be resumed, the USPTO will post the information on the USPTO website at [www.uspto.gov](http://www.uspto.gov) and a final notice will be published in the Official Gazette regarding the postal interruption in New York City.

It would be appreciated if members of the public would bring to the USPTO's attention any other post office closings related to current events. Such information can be brought to the USPTO's attention by contacting Eugenia Jones by e-mail at [eugenia.jones@uspto.gov](mailto:eugenia.jones@uspto.gov) or telephone at 703-306-5586, or by contacting Carol Smith by e-mail at [carol.smith@uspto.gov](mailto:carol.smith@uspto.gov) or by telephone at 703-308-8910 (ext 149).

#### UNITED STATES POSTAL SERVICE INTERRUPTIONS RELATING TO EXPRESS MAIL SERVICE

##### Where the USPS refuses to accept the deposit of mail for delivery by express mail.

In some cases, due to the recent emergency, certain post offices are refusing to accept the deposit of mail for delivery by Express Mail service. The USPTO is also designating this interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 C.F.R. 1.6(e). In addition, if a party attempts to deposit correspondence for delivery to the USPTO with the USPS by Express Mail under 37 CFR 1.10 ("Express Mail Post Office to Addressee") and the USPS refuses to accept such correspondence, the party is advised to take the following action: mail the correspondence to the USPTO by registered or first class mail with a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail. The statement must indicate the date on which the person attempted to deposit the correspondence with the USPS and that the USPS refused to accept the correspondence. The statement must be signed in accordance with 37 CFR 10.18. The correspondence should be mailed as set out in 37 CFR 1.1(a) and include the special box designation: BOX FILING DATE.

##### Where mail is put into an Express Mail "Drop Box" and given an incorrect "date in".

In some cases a person may use an Express Mail "drop box" without realizing that the local post office is not accepting Express Mail. In that situation, the provisions of 37 CFR 1.10(d) may apply. Usually 37 CFR 1.10(d) is invoked where correspondence is placed in an Express Mail "drop box" prior to the last pick up that is scheduled for the drop box for that day, but the USPS enters an incorrect "date-in" on the Express Mail mailing label, usually the next day's date. To invoke 37 CFR 1.10(d), however, a petition must be corroborated either by evidence from the USPS or by evidence that came into being after deposit and within one business day of the deposit of the correspondence in the Express Mail drop box (e.g., a copy of a log book indicating that the correspondence was deposited on the date in question). See MPEP 513 and TMEP 702.02(e).

ENCLOSURE 9

09/932,013

AMENDED PETITION UNDER 37 CFR §1.55(c)

## **Alternative Procedure Invoking "Extraordinary Circumstances"**

If a party can demonstrate that due to extraordinary circumstances the above procedures could not be followed, it will be necessary to file a petition under 37 C.F.R. 1.183 (patent matter) or 2.146(a)(5) and 2.148 (trademark matter) to waive the requirements of 37 C.F.R. 1.10 to permit the USPTO to accord the correspondence a filing date as of the date that Express Mail deposit was attempted. Such a petition must be accompanied by a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail, stating the date that the deposit was attempted and that the USPS refused to accept the correspondence, and be signed by such person subject to the conditions prescribed in 37 CFR 10.18.

## **Certificates of Mailing Under 37 CFR 1.8**

Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

Date: 13 September 2001

/s/

Nicholas P. Godici  
Acting Under Secretary of Commerce for  
Intellectual Property and Acting Director of the  
United States Patent and Trademark Office

**NOTE:** Effective June 24, 2002, 37 C.F.R. §1.10(a) has been amended. The Express Mail procedure provided in 37 C.F.R. §1.10 no longer applies to any of the following trademark documents:

- Trademark/Service Mark Application under §1 or §44 of the Trademark Act, 15 U.S.C. §1051 or §1126
- Statement of Use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d)
- Amendment to Allege Use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c)
- Request for Extension of Time to File a Statement of Use under §1(d) of the Trademark Act, 15 U.S.C. §1051(d)
- Affidavit or Declaration of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. §1058
- Renewal Request under Section 9 of the Trademark Act, 15 U.S.C. §1059
- Combined Filing under Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§1058 and 1059
- Combined Affidavit or Declaration under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§1058 and 1065
- Request to Change or Correct Address

If the documents listed above are filed by Express Mail, they will receive a filing date as of the date of receipt in the Office and not the date of deposit with the United States Postal Service. See notice at 67 Fed. Reg. 36099 (May 23, 2002) [PDF].

---

*Is there a question about what the USPTO can or cannot do that you cannot find an answer for? Send questions about USPTO programs and services to the USPTO Contact Center (UCC). You can suggest USPTO webpages or material you would like featured on this section by E-mail to the webmaster@uspto.gov. While we cannot promise to accommodate all requests, your suggestions will be considered and may lead to other improvements on the website.*

